

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

Nos. 9911 - 9912

172

BRIEF FOR APPELLANT AND JOINT APPENDIX

United States Court of Appeals

DISTRICT OF COLUMBIA

*United States Court of Appeals
for the District of Columbia*

No. 9911

FILED SEP - 1 1948

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

Joseph W. Stewart
CLERK

No. 9912

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

**Appeal from the District Court of the United States
for the District of Columbia**

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United States Court of Appeals

DISTRICT OF COLUMBIA

Nos. 9911—12

GARDEL INDUSTRIES, *Appellant*,

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,
and

NANCY ANN STORYBOOK DOLLS, INC., *Appellees*.

BRIEF FOR APPELLANT

JURISDICTIONAL STATEMENT

This is an appeal from Order (21A)¹ of the District Court of the United States for the District of Columbia granting Appellees' motions (18A and 20A) to dismiss the Complaints (2A and 12A) in Civil Actions Nos. 717-48 and 718-48, filed February 20, 1948, against the Commissioner of Patents and Nancy Ann Storybook Dolls, Inc., co-defendants. These actions were brought under the provisions of Section 4915 of the Revised Statutes (U. S. C. Title 35, Sec. 63) and judgment is sought to have the Commissioner of Patents issue to the Appellant Certificates of Registration of its two marks "BIRTHSTONE DOLL" and "BIRTHSTONE DOLL OF THE MONTH" covered in two applications, Serial Nos. 479,619 and 479,620, filed February 9, 1945.

¹ The numbers in parentheses refer to pages in the joint appendix.

The Defendant-Appellee, Lawrence C. Kingsland, is sued in his official capacity as Commissioner of Patents, his official residence being in the District of Columbia.

The Co-defendant-Appellee, Nancy Ann Storybook Dolls, Inc., a California corporation, is named as a Defendant and formal party to the suit by reason of its opposition filed in the Patent Office to the registration of Appellant's marks, service on said Defendant having been made on an officer of the corporation by the Deputy United States Marshal of the United States District Court for the District of California (7A and 17A).

The First Assistant Commissioner of Patents, in a decision dated August 21, 1947, refused to register Appellant's trademarks, reversing the Interference Examiner who had previously dismissed oppositions and adjudged Appellant entitled to the registrations. Without having taken appeals to the U. S. Court of Customs and Patent Appeals, and within six months of the said refusal to register the marks, Gardel Industries filed its complaints in the District Court of the United States for the District of Columbia requesting judgment that it was the sole and exclusive owner of the trade-marks covered in the afore-said applications for registration and that it was entitled to the registrations of said trade-marks.

STATUTES INVOLVED

The pertinent sections or portions of the Statutes involving jurisdiction are as follows:—

Revised Statutes, Title LX: Sec. 4915, (U. S. C., title 35, sec. 63)

“Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Pat-

ent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in this suit."

U. S. C. Title 35, Sec. 72a.

"Jurisdiction of district court of the United States for the District of Columbia in certain equity suits where adverse parties reside elsewhere; plurality of districts; service of writs

"Upon the filing of a bill in the district court of the United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court

shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct. March 3, 1927, c. 364, 44 Stat. 1394; June 25, 1936, c. 804, 49 Stat. 1921."

Section 737 of the Revised Statutes (Act of Mar. 3, 1911, c. 231, Sec. 50, 36 Stat. 1101), 28 U. S. C. A., Section 111:

"When part of several defendants cannot be served.

"When there are several defendants in any suit at law or equity, and one or more of them are neither inhabitants of nor found within the district in which the suit is brought, and do not voluntarily appear, the court may entertain jurisdiction, and proceed to the trial and adjudication of the suit between the parties who are properly before it; but the judgment or decree rendered therein shall not conclude or prejudice other parties not regularly served with process nor voluntarily appearing to answer; and nonjoinder of parties who are not inhabitants of nor found within the district, as aforesaid, shall not constitute matter of abatement or objection to the suit."

U. S. C. Title 15, Sec. 89.

"Appeal from decision of Commissioner of Patents.

"If an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the United States Court of Customs and Patent Appeals, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage

of such proceedings, as far as the same may be applicable. Feb. 20, 1905, c. 592, Sec. 9, 33 Stat. 727; Mar. 2, 1929, c. 488, Sec. 2(b), 45 Stat. 1476.”

U. S. C. Title 28, Sec. 41.

The district courts shall have original jurisdiction, as follows:—

* * * *

“Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws.

“The District Court of the United States for the District of Columbia (formerly the Supreme Court of the District of Columbia) in patent causes has district court jurisdiction—Cochrane v. Deener, 94 U. S. 780, 11 O. G. 687.”

U. S. C. Title 28, Sec. 225.

(a) The circuit court of appeals shall have appellate jurisdiction to review by appeal final decisions—(Amended by act of Feb. 13, 1925).

“First. In the District Courts, in all cases save where a direct review of the decision may be had in the Supreme Court under section two hundred and thirty-eight. (U. S. C., title 28, sec. 345).”

Section 5 of the Trade-Mark Act of 1905

U. S. C. Title 15, Sec. 85:

* * * *

“That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered * * *”.

STATEMENT OF CASE

Gardel Industries, having adopted and used, as sole and exclusive owner thereof, the two original, arbitrary and distinctive trade-marks, for miniature dolls, "BIRTHSTONE DOLL" and "BIRTHSTONE DOLL OF THE MONTH", and being entitled to the exclusive right to the use thereof on such goods, duly filed applications for registration thereof in the United States Patent Office, in accordance with the Trade-Mark Act of February 20, 1905. The Examiner of Trade-Marks, after due examination, acted favorably on the applications and the trade-marks were duly published in the Official Gazette of the United States Patent Office under date of April 10, 1945 (3A).

On May 7, 1945, Nancy Ann Dressed Dolls, a partnership, predecessor of the defendant, Nancy Ann Storybook Dolls, Inc., filed oppositions to registration of said marks, alleging ownership and use of twelve registered trade-marks covering the words "JANUARY GIRL", "FEBRUARY GIRL", "MARCH GIRL", etc. (one for each month of the year), and also alleging ownership of pending applications for registration of the alleged trade-marks "BIRTHDAY DOLL" and "DOLLS OF THE MONTH" and further alleging confusing similarity between the marks of the Appellant and the alleged marks of said Defendant-Appellee (3A and 13A). Plaintiff-Appellant filed its answers to the notices of opposition and testimony was taken by both parties and duly made of record in the Patent Office.

An assignment was recorded in the Patent Office transferring the marks of the opposer to Nancy Ann Storybook Dolls, Inc., and the latter was substituted as opposer in the Patent Office proceedings and correspondingly as co-defendant in the Court proceedings.

After a hearing on the evidence before the Patent Office, the Interference Examiner for Trade-Marks, under date

of August 7, 1946, rendered decisions dismissing the oppositions and adjudging Gardel Industries, Appellant herein, entitled to the registrations for which it made application. This affirmed the decision of the Trade-Mark Examiner in favorably acting on the applications and passing same to publication.

Appeals were then taken by the Nancy Ann Storybook Dolls, Inc., to the Commissioner of Patents and after hearing thereon, the First Assistant Commissioner, under date of August 21, 1947, rendered decisions reversing the Interference Examiner, thereby sustaining the notices of opposition and adjudging the Appellant not entitled to the registrations for which it made application.

Suits were instituted in the District Court of the United States for the District of Columbia under Section 4915 of the Revised Statutes to compel the Commissioner of Patents to grant the registrations on the applications aforesaid. The Commissioner was named defendant, since he is the only tribunal authorized by law to grant registrations of trade-marks and is a trustee of the public interests and, therefore, a proper, necessary and indispensable party. Nancy Ann Storybook Dolls, Inc., the substituted opposer in the Patent Office, and a California corporation, was named as a co-defendant, as a formal party to the proceedings, although not believed to be an indispensable party thereto. These actions were titled Civil Actions Nos. 717-48 and 718-48 (2A and 11A).

Thereafter, on or about March 12, 1948, defendant, Nancy Ann Storybook Dolls, Inc., filed in the District Court a motion to dismiss the complaints on the ground that (1) the Court is without jurisdiction because it (defendant) was not within the jurisdiction or subject to process of the Court; (2) the Commissioner of Patents is only a nominal defendant and not an adverse party to the action within the contemplation of R. S. Sec. 4915, 35 U. S. C. A. Sec. 63 and 72a for the purpose of determining jurisdic-

tion of the Court, and (3) defendant has not been duly or properly served.

Likewise, the Commissioner of Patents, on or about March 15, 1948, filed motion to dismiss, joining in the motion of the co-defendant and on the further ground that the actions can not proceed against the Commissioner of Patents alone in the absence of the necessary party, Nancy Ann Storybook Dolls, Inc.

Hearing was had on the motions before Justice Letts of the District Court of the United States for the District of Columbia, and thereafter, the motions to dismiss were granted and orders thereon entered April 30, 1948, dismissing the complaints (10A, 11A, and 21A). Notice of Appeal was filed by Plaintiff-Appellant on May 28, 1948 (21A).

STATEMENT OF POINTS

Appellant states the following points of error in the decision and judgment below:—

(1) The Court erred in granting Appellees' motions to dismiss and in dismissing the complaints.

(2) The Court erred in failing to hold that the Commissioner of Patents is an indispensable party or a proper party in an action under Sec. 4915 R. S. and may be sued alone.

(3) The Court erred in failing to hold that the Commissioner of Patents is an indispensable or proper party in an action under Sec. 4915 R. S. for the registration of a trade-mark, following opposition in the Patent Office based on alleged similarity of trade-marks.

(4) The Court erred in holding that it is without jurisdiction because one of the defendants is not within the jurisdiction or subject to the process of the Court.

(5) The Court erred in holding that the Commissioner of Patents is only a nominal defendant and not an adverse party to the action within the contemplation of the Statutes.

(6) The Court erred in holding that the action can not proceed against the Commissioner of Patents alone in the absence of the necessary party, Nancy Ann Storybook Dolls, Inc.

(7) The Court erred in failing to hold that Nancy Ann Storybook Dolls, Inc., is not an indispensable or necessary party to this action.

(8) The Court erred in failing to hold that the Nancy Ann Storybook Dolls, Inc., is merely a formal or nominal party to the action.

(9) The Court erred in failing to hold that if Nancy Ann Storybook Dolls, Inc., is a necessary or indispensable party to the action, the Commissioner of Patents is also an indispensable and necessary party thereto, and as such both parties may be considered adverse parties, within the meaning of the Statutes, so that the non-resident corporation defendant has been properly served and is within the jurisdiction of the Court.

(10) The Court erred in failing to dismiss the motions of the appellees.

SUMMARY OF ARGUMENT

The judgment of the lower Court dismissing the complaints in this case is directly contrary to prior decisions of this Court in *Tomlinson of High Point v. Coe*, 74 App. D. C. 364; 123 F. (2d) 65, and *Speed Products Company, Inc. v. Tinnerman Products, Inc. and Commissioner of Patents*, No. 9700, decided May 18, 1948.

The Commissioner of Patents refused to register Appellant's trade-marks on the ground of confusing similarity to certain unregistered "known" trade-marks alleged to be "owned and in use by another and appropriated to merchandise of the same descriptive properties", in accordance with Sec. 5 of the Trade-Mark Act of 1905.

This issue of confusing similarity between a mark for which application to register has been filed and a known trade-mark owned and in use by another is an "ex parte" issue under Sec. 5 of the Trade-Mark Act of 1905.

In an action under Sec. 4915 R. S., seeking a decree authorizing the Commissioner of Patents to grant registration of a mark denied by him as unregistrable by virtue of an adverse decision on one of the "ex parte" issues specified in Sec. 5 of the Trade-Mark Act of 1905, the Commissioner of Patents is an indispensable party.

The Commissioner of Patents is trustee for the interests of the public and it is he only that may grant registrations of trade-marks. It is he only to whom a mandate may be directed compelling the issue of a registration and he would not be bound by the mandate of a Court outside of the jurisdiction of the District of Columbia. He, therefore, is an indispensable and proper party to this action.

No action may be brought against the Commissioner of Patents without his consent in any jurisdiction other than the District of Columbia where he has his official residence.

This Court has for many years exercised jurisdiction of actions under Sec. 4915 R. S. against the Commissioner of Patents alone following his refusal to register an applicant's mark on the ground that it was confusingly similar to a registered mark. The Court of Customs and Patent Appeals has for years also exercised jurisdiction to decide such issue on "ex parte" appeal.

The opposer in the Patent Office opposition proceeding is merely a formal party, presenting to the Patent Office, if possible, some grounds for refusal by the Commissioner of a trade-mark sought to be registered under the Statute. If he shows to the Patent Office use of a mark the same or similar to the mark sought to be registered, the ground for refusal to register an applicant's mark becomes an "ex parte" ground provided for in Sec. 5 of the Trade-Mark Act of 1905.

Thus, the Commissioner of Patents may be sued alone in an action such as this under Sec. 4915 R. S.

If it is determined that the opposer to the application for registration, Nancy Ann Storybook Dolls, Inc., is a necessary party, or an indispensable party, then the Commissioner of Patents, as aforesaid, is likewise an indispensable party and the District Court of the U. S. for the District of Columbia has jurisdiction over the parties properly served herein.

If the Statute is interpreted literally with respect to the words "adverse" parties, and the opposer-appellee, Nancy Ann Storybook Dolls, Inc., is considered an "adverse" party, then, likewise, the Commissioner of Patents may be considered an "adverse" party, within the meaning of the law, since he is a trustee for the interests of the public with respect to granting of trade-mark registrations, and one who is interested in upholding the judgment sought to be reversed.

ARGUMENT

The principal question in issue before this Court is whether the Commissioner of Patents may be sued alone in the District Court of the District of Columbia in an action under Sec. 4915 of the Revised Statutes, following a trade-mark opposition proceeding in the Patent Office

and the denial of the registration to the applicant on the grounds of confusing similarity between applicant's mark and an unregistered mark of the opposer.

Another question to be decided is whether, under the circumstances aforesaid, the opposer before the Patent Office is an indispensable party to the subsequent Court action, or may be made merely a formal party thereto. Further, if the opposer is an indispensable party, whether he is properly within the jurisdiction of the Court when named as co-defendant with the Commissioner of Patents in this jurisdiction and service of summons made through the Office of the Marshal in the District where the non-resident is domiciled.

This Court had before it the question of whether the Commissioner of Patents may be sued alone in the case of *Tomlinson of High Point v. Coe*, 74 App. D. C. 364, 123 F. (2d) 265. There the same, or substantially the same, facts were present in that there was an opposition in the Patent Office, the opposer relying on the use of a name or mark which was not registered. The Commissioner of Patents held the applicant's mark not registrable and the applicant for registration entered suit against the Commissioner alone. On motion to dismiss by the Commissioner of Patents, this Court very clearly, and in no unmistakable terms, held that the Commissioner of Patents may be sued alone and that the Commissioner is a "proper party in all proceedings, properly brought under Section 4915, in which the public interest is involved because of the necessity of determining whether it is the duty of the Commissioner to grant a patent or register a trade-mark." The Court recognized in this case the fact that the Commissioner "acts in the public interest" whether it grants or refuses a patent or a trade-mark registration.

The District Court in the case at bar chose not to follow the decision of this Court in the *Tomlinson* case, *supra*, but assigned no reasons therefor.

As aforesaid, in the *Tomlinson* case, the opposer did not rely on a registered mark but merely on a "known" mark which it was using, which is the same state of facts in the case at bar. The appellant here is endeavoring to secure registration of its marks and, as this Court also stated in *Tomlinson, supra*, the "proceeding by bill in equity under Section 4915 R. S. is 'a part of the application for patent' or for registration of the trade-mark." The refusal to register by the Commissioner was clearly based on the Sec. 5 of the Trade-Mark Act of 1905 and, therefore, an "ex parte" ground of rejection or refusal.

The fact that the appellant named also the opposer in the Patent Office, a non-resident, as party defendant is of no moment. Section 4915 of the Revised Statutes, under which this action is brought, does not specify the parties defendant and makes no party indispensable except the applicant for patent or registration. If the non-resident defendant, opposer in the Patent Office, desires not to be a party to this action, appellant has no objection thereto, since that party has no registered mark involved in this proceeding and, technically, has no interest therein, except it be formal.

The Courts have recognized three classes of parties:

- (1) *Formal parties*, who are persons having some, though minor, interest in the subject matter of the controversy.
- (2) *Necessary parties*, who are persons having a substantial interest in the controversy and who ought to be made parties, if their joinder would not oust the court of jurisdiction, in order that the court may act on that rule which requires it to decide on, and finally determine all phases of the controversy, and do complete justice by adjusting all the rights involved in the controversy, but these parties are not indispensable.
- (3) Persons who not only have an interest in the controversy, but an interest of such a nature that a

final decree cannot by "due process" of law be made without either affecting that interest, or leaving the controversy in such a condition that its final determination may be wholly inconsistent with equity and good conscience.

(*Shields et al. v. Barrow*, 17 Howard 130, 58 U. S. 158, 160; *Mallow et al. v. Hinde*, 12 Wheaton 193; *Oxley v. Sweetland*, 94 F. (2d) 33; *Ford v. Adkins*, 39 F. S. 472).

We submit that the Commissioner of Patents is in the 3rd or last category list above, that is, an indispensable party to this action. Nancy Ann Storybook Dolls, Inc. is merely a "formal party" named in category (1) hereabove.

Section 50 of the Judicial Code (28 U. S. C. A. 111) provides that when there are several defendants in any suit at law or in equity and one or more of them are not within the jurisdiction of the court in which suit is brought, the court may entertain jurisdiction and proceed with the trial and adjudication of the suit between the parties before it.

This section of the Judicial Code and the like section of the Act of Congress of February 28, 1839, have been frequently reviewed by the courts. They have held that that section gives jurisdiction to the Federal courts in the absence of formal and necessary parties, but can not give jurisdiction in the absence of indispensable parties because of the constitutional requirement of "due process". (Constitution, Amendment 5; *Shields v. Barrow*, *supra*; *Mallow v. Hinde*, *supra*).

The constitutional requirement of due process applies not only to the courts but to administrative proceedings as well. (*Morgan v. U. S.*, 304 U. S. 1; *Edison Co. v. Labor Board*, 305 U. S. 197).

Sections 5 and 6 of the Trade-Mark Act of 1905 (U. S. C. Title 15, Sections 85 and 86) provide that the Commis-

sioner of Patents shall on examination of trade-mark applications refuse registration of trade-mark "which so nearly resemble a registered or *known* trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers".

Under these Sections of the Act, the Commissioner since the promulgation of the law has uniformly considered "ex parte" the question of whether a trade-mark applied for is or is not confusingly similar to a registered mark. By the same token, the refusal to register or grant registration to an applicant by reason of knowledge gained by the Commissioner through an intervenor or opposer is based on the Sections of the Act aforementioned. Refusal under these conditions would be an "ex parte" ground of rejection. On purely "ex parte" grounds, action under Section 4915 must necessarily be brought against the Commissioner of Patents.

The opposing party in the Patent Office proceedings does not represent the public (*Frankfort Distilleries, Inc. v. Dextora Co.*, 103 F. (2d) 924; 26 CCPA (Patents) 1244). However, the public interest and the necessities of the case require service to be made upon the Commissioner (*Tomlinson of High Point v. Coe, supra*).

The primary purpose of the Trade-Mark Act is to prevent confusion and mistake in the mind of the public (*Skol Co. v. Olson*, 151 F. (2d) 200; 33 CCPA (Patents) 715). No party other than the Commissioner can under the Statute represent the public interest in the successful accomplishment of that purpose.

This Court has several times considered the question of whether an opposer in a Patent Office opposition or cancellation proceeding is an indispensable party and has held that when the issue is the registrability of the appel-

lant's mark, the opposer is not an indispensable party but that the action may proceed against the Commissioner of Patents alone (*Alexandrine v. Coe*, 63 App. D. C. 127, 71 F. (2d) 348; *Thorne, Neale & Co., Inc. v. Coe*, 143 F. (2d) 155, 79 U. S. App. D. C. 122; *Tomlinson v. Coe*, *supra* and *Speed Products Co., Inc. v. Tinnerman Products, Inc., et al.*, *supra*.)

In *Speed Products Company, Inc. v. Tinnerman Products, Inc.*, *supra*, decided May 18, 1948, this Court definitely decided that the Commissioner of Patents may be sued alone in this jurisdiction, and cited with approval the *Tomlinson* case, *supra*.

It will be seen from the foregoing, that the Commissioner of Patents is not only a proper and necessary party to an action under Section 4915 for the registration of a trade-mark, but is an indispensable party thereto.

Whether the opposer is a formal, necessary or indispensable party is immaterial. Appellant considers that he is only a "formal" party, and Nancy Ann Storybook Dolls, Inc., was only named as such, more as a matter of courtesy, giving it the right to appear, if it so desired, to present its arguments. So long as the indispensable party, namely, the Commissioner of Patents, has been made a party to the action, this proceeding may continue, according to the law as determined by this Court.

If, it is contended by the appellees that the defendants in this jurisdiction must be both "adverse parties", we submit that the Commissioner of Patents, as an indispensable party, may be considered an "adverse" party. While he may have no ownership-interest in the registration to be granted to the applicant, he is, as aforesaid, a trustee for or custodian of the interests of the public. It is his duty to see that the interests of the public are protected. As such, the Commissioner is an "adverse" party.

The expression "adverse party" is held to include all parties who have an interest in opposing the object sought to be accomplished by an appeal. (*Cummings v. Reins Copper Co.*, 107 Pac. 905, 907). Every party interested in sustaining the judgment or decree is an "adverse party" (*Moody v. Miller*, 33 Pac. 402). As trustee for the interests of the public, the Commissioner is the same as an administrator of an estate and the latter is recognized as an "adverse party" (*Kasson v. Brocker's Estate*, 47 Wis. 79; 1 N. W. 418). An "adverse party" to the plaintiff in error on appeal is one who is interested in upholding the judgment sought to be reversed. (*Scott v. Amis*, 276 Pac. 215; 136 Okla. 72).

Thus, if the Statute is to be interpreted so as to require all parties defendant in an action in this jurisdiction to be "adverse" parties, it is satisfied by the showing that the Commissioner of Patents in a trade-mark proceeding involving the right of registration is, in fact, an "adverse" party. If the co-defendant considers itself to be an adverse party, it was properly named as defendant in this action with the Commissioner. If the co-defendant considers itself indispensable, it was properly named defendant along with the Commissioner, who has been shown to be also indispensable. If the co-defendant does not consider itself indispensable and merely a formal party, as we submit it is, dismissal of such party from this action is acceptable to the appellant.

Rule 21 of the Rules of Civil Procedure provides:

"Misjoinder of parties is not ground for dismissal of an action. Parties may be dropped or added by order of the Court on motion of any party or of its own initiative and on such terms as are just. Any claim against a party may be severed and proceeded with separately."

If a claim is dismissed as against a party who is not indispensable, the original jurisdiction survives against the

remaining party. (*Interstate Refineries, Inc. v. Barry*, 7 F. (2d) 548, C. C. A. 8th).

In the argument of this case before the District Court, Mr. Justice Letts was inclined to favor the plaintiff-appellant and deny the motions to dismiss, but the Solicitor for the Commissioner called attention to a similar case decided by Justice Proctor, wherein the motion to dismiss was granted. This case was Civil Action No. 1392-47, *Salvatore Reins, d/b/a Salva-Gene Chemical Laboratory v. Casper W. Ooms, Commissioner of Patents and Schering Corporation*. Apparently, in deciding the case, Justice Proctor did not have before him all the decisions herein presented, particularly those of the U. S. Court of Appeals for the District of Columbia. As far as counsel is advised, the aforesaid case has not been appealed to this Court.

CONCLUSION

We submit that the judgment on the motions to dismiss the complaints, and the dismissals of the complaints, should be reversed, and such action is most earnestly prayed for.

Respectfully submitted,

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1 A

United States Court of Appeals

DISTRICT OF COLUMBIA

Nos. 9911, 9912

No. 9911

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

No. 9912

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

Appeal from the District Court of the United States
for the District of Columbia

JOINT APPENDIX TO BRIEFS

1 Filed Feb 20 1948 Harry M. Hull, Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Gardel Industries, 42 Tiffany Place, Brooklyn 2, New York,
Plaintiff,

V.

Lawrence C. Kingsland, U. S. Patent Office, Washington,
D. C., as Commissioner of Patents, and

Nancy Ann Storybook Dolls, Inc., (Successor to Nancy Ann Dressed Dolls), 1298 Post Street, San Francisco 9, California, Defendants.

CIVIL ACTION No. 717-48
Under Section 4915, Revised Statutes.

Complaint

The plaintiff alleges and represents, as follows:—

1. The plaintiff, Gardel Industries, is a partnership composed of Benjamin Dresher and Samuel H. Geffner, with a factory and office for the transaction of business at 42 Tiffany Place, in the City of Brooklyn, County of Kings, State of New York, Postal Zone 2.

2. The defendant, Lawrence C. Kingsland, is the Commissioner of Patents of the United States of America, a resident and inhabitant of the District of Columbia, and he is sued herewith because of certain acts and things done by him, by virtue of the powers of his office, and in the course of the alleged performance of his duties as Commissioner of Patents.

3. The defendant, Nancy Ann Storybook Dolls, Inc., as plaintiff is informed, is a corporation organized
2 and existing under and by virtue of the Laws of the State of California, with an office for the transaction of business at 1298 Post Street, in the City of San Francisco, County of San Francisco, State of California, Postal Zone 9.

4. This Court has jurisdiction over this action, under the provisions of the Trade-Mark Act of 1905, as amended, under the Trade-Mark Act of 1946, under U. S. Code, Title 35, Sec. 63, and under U. S. Code, Title 35, Sec. 72 (a).

5. Since September, 1944, and continuously since that date, plaintiff has used as a trade-mark the arbitrary words "Birthstone Doll", as applied to dolls produced and sold by it in interstate commerce throughout the

United States to designate origin of such merchandise in plaintiff and being the owner of said trade-mark and entitled to the exclusive use thereof, as applied to dolls, sold and distributed in interstate commerce throughout the United States, plaintiff on February 9, 1945, filed its application for registration of the trade-mark "Birthstone Doll" in the United States Patent Office, in accordance with the Act of February 20, 1905 after due examination and compliance with the Laws, in such cases made and provided, and the Rules of Practice of the United States Patent Office, said trade-mark was favorably acted upon by the Examiner of Trade-Marks, duly passed to publication, and published in the Official Gazette of the United States Patent Office, dated April 10, 1945.

6. On or about May 7, 1945, Nancy Ann Dressed Dolls, a partnership, composed of Nancy Ann Abbott, Allen N. Roland and Frederick E. Andersen, predecessor of the defendant, Nancy Ann Storybook Dolls, Inc., of 1298 Post Street, San Francisco 9, California, filed opposition
3 to the registration of plaintiff's aforesaid trade-mark, alleging ownership of twelve registered trade-marks covering the words "January Girl", "February Girl", "March Girl", etc. (one for each month of the year), and also alleging ownership of pending applications for registration of alleged trade-marks "Birthday Doll" and "Dolls of the Month", and still further alleging confusing similarity between the mark of the plaintiff and the alleged marks of said defendant. Said opposition proceeding was titled Nancy Ann Dressed Dolls v. Gardel Industries, Opposition No. 24,253; and after plaintiff filed answer on June 20, 1945, to the Notice of Opposition, testimony was taken by both parties and duly made of record in the United States Patent Office.

7. Following the taking of testimony, there having been recorded in the Title Division of the United States Patent Office an assignment, dated January 7, 1946, purporting to transfer all trade-marks and good will from

Nancy Ann Dressed Dolls, a partnership, to Nancy Ann Storybook Dolls, Inc., a California corporation, the United States Patent Office, on motion of the opposer, substituted said Nancy Ann Storybook Dolls, Inc., as assignee-opposer, the proceeding being thereafter titled: Nancy Ann Dressed Dolls (Nancy Ann Storybook Dolls, Inc., assignee, substituted) v. Gardel Industries, Opposition No. 24,253.

8. A hearing was had before the Examiner of Trade-mark Interferences on April 12, 1946, and on August 7, 1946, said Examiner of Interferences rendered a decision dismissing the opposition and adjudging Gardel Industries, plaintiff herein, entitled to the registration for which it made application. Defendant duly took an appeal from said decision to the Commissioner of Patents and
4 after hearing on May 15, 1947, before said tribunal, the First Assistant Commissioner rendered a decision, dated August 21, 1947, reversing the decision of the Examiner of Interferences.

9. The plaintiff herein has taken no appeal to the United States Court of Customs and Patent Appeals from the aforesaid decision of the First Assistant Commissioner of Patents.

10. Plaintiff is engaged in the manufacture and sale of dolls and since September, 1944, has adopted and used in connection with the sale of certain of its dolls the original and arbitrary trade-mark "Birthstone Doll", the same being displayed on a tag attached to the dolls, and also utilizing in connection with said dolls certain birthstones, as representing months of the year within which birthdays occur. Large sums of money have been expended by plaintiff in advertising the dolls under its original and arbitrary trade-mark "Birthstone Doll" and the public has come to recognize dolls bearing said trade-mark as originating with the plaintiff. As plaintiff is informed and believes and, therefore, charges the fact to be, no other manufacturer or distributor of dolls, including the defendant, has used the same or a confusingly similar trade-mark on dolls, from a date prior to plaintiff's first date of use of said trade-mark.

11. The defendant, Nancy Ann Storybook Dolls, Inc., and its predecessors from whom title is alleged to have been derived, claim ownership of certain prior registrations of trade-marks referring to months of the year, such as "January Girl", "February Girl", "March Girl", etc., as applied to dolls, but if defendant owns such trade-marks and has had prior use thereof, it is not damaged by the registration of plaintiff's aforesaid trade-mark, in that the latter is not confusingly similar to defendant's said marks. Defendant also claims prior use and ownership of alleged trade-marks "Birthday Dolls" and "Dolls of the Month", but plaintiff avers that defendant has not shown nor legally proven use of said trade-marks from a date prior to the first date of use by plaintiff of its aforesaid trade-mark, so that defendant cannot be damaged, within the meaning of the Trade-Mark Law, by the registration of plaintiff's aforesaid trade-mark.

12. Plaintiff further avers that its trade-mark "Birthstone Doll" is distinctively and registrably different from any trade-mark legally owned and used by the defendant, and/or its predecessors, from any date prior to the first date of use by plaintiff of its trade-mark aforesaid.

13. The defendant, Lawrence C. Kingsland, acting as Commissioner of Patents, notwithstanding the facts and evidence, has reversed the decision of the Examiner of Interferences dismissing the opposition of the defendant, thereby denying plaintiff registration of its trade-mark, to the great and irrevocable injury of plaintiff for which it has no remedy at law.

Plaintiff, therefore, prays for the following relief:—

A. That judgment be granted in favor of plaintiff adjudging that plaintiff is the sole and exclusive owner of the trade-mark "Birthstone Doll" and that said trade-mark is distinctively and registrably different from any trade-mark owned and used by the defendant, Nancy Ann Storybook Dolls, Inc.

B. That plaintiff was the first to adopt and use the trade-mark "Birthstone Doll" as applied to dolls sold in

interstate commerce throughout the United States and that defendant has not proven use of its alleged trade-marks "Birthday Dolls" and "Dolls of the Month" from a date prior to the date of first use by plaintiff of its aforesaid trade-mark.

C. That plaintiff's trade-mark does not resemble defendant's registered trade-marks or any other valid trade-marks of the defendant of which it may have had priority.

D. That the defendant's alleged trade-mark "Dolls of the Month" is merely a descriptive expression, not capable of exclusive appropriation.

E. That judgment be granted holding plaintiff's trade-mark "Birthstone Doll", with the descriptive word "Doll" disclaimed, is registrable and that the opposition in the United States Patent Office by the defendant should be dismissed.

F. That a writ be issued under U. S. Code, Title 35, Sec. 72 (a), against the defendant, Nancy Ann Storybook Dolls, Inc., and that such other and further relief be granted as may be deemed proper.

GARDEL INDUSTRIES,
By Herbert J. Jacobi,
By Herbert J. Jacobi,
966 National Press Building,
Washington 4, D. C.,
Attorney for Plaintiff.

February 20, 1948.

* * * *

9 Summons in a Civil Action D. C. Form No. 45 Rev.
DISTRICT COURT OF THE UNITED STATES

For the

District of Columbia

Civil Division

Civil Action File No. 717-48

Gardel Industries, Plaintiff, v. Lawrence C. Kingsland,
Commissioner of Patents

7 A

Nancy Ann Storybook Dolls, Inc.
(Successor to Nancy Ann Dressed Dolls)
Defendant

SUMMONS

Received Feb 24 1948 U. S. Marshal's Office
San Francisco, Calif.

Civil 28269

To the above named Defendant:

You are hereby summoned and required to serve upon

HERBERT J. JACOBI

plaintiff's attorney, whose address is 966 National Press
Building, Washington, (4), D. C.,

an answer to the complaint which is herewith served upon
you, within 20 days after service of this summons upon
you, exclusive of the day of service. If you fail to do
so, judgment by default will be taken against you for the
relief demanded in the complaint.

Harry M. Hull

Clerk of Court

By Anna M. Thompson

Deputy Clerk

Date: Feb. 20, 1948

(Seal of Court)

Note.—This summons is issued pursuant to Rule 4 of
the Federal Rules of Civil Procedure.

10 RETURN ON SERVICE OF WRIT

I hereby certify and return, that on the 25th
day of February 1948, I received the within summons and
complaint and served the same on Nancy Ann Storybook
Dolls, Inc., by serving A. L. Rowland as Secretary at San
Francisco California on the 25th day of February 1948.

George Vice

United States Marshal

By Herbert R. Cole

Deputy United States Marshal

Marshal's Fees

Travel \$.40

Service 2.00

2.40

* * * *

11 Filed Mar 12 1948 Harry M. Hull, Clerk

Notice of Motion to Dismiss

To Gardel Industries, Plaintiff above named, and to Herbert J. Jacobi, its attorney:

To Lawrence C. Kingsland, Commissioner of Patents, Defendant above named, and to W. W. Cochran, Solicitor of the U. S. Patent Office, his attorney:

You and each of you will please take notice that on Monday, the 12th day of April, 1948, in the courtroom of the above entitled court in the Court House Building, Washington, D. C., at the hour of 9:45 O'clock A. M. or as soon thereafter as counsel can be heard, defendant will present the accompanying Motion to Dismiss.

Dated: Washington, D. C.
March 12, 1948

Raymond J. Mawhinney
Attorney for Nancy Ann
Storybook Dolls, Inc.
Raymond J. Mawhinney
444 Munsey Building
Washington, D. C.

12 Due service and receipt of a copy of the above Notice of Motion to Dismiss and of the accompanying Motion to Dismiss is acknowledged this 12th day of March, 1948.

Herbert J. Jacobi
Attorney for Gardel
Industries
W. W. Cochran
Solicitor, U. S. Patent Office

* * * *

Motion to Dismiss

Defendant Nancy Ann Storybook Dolls, Inc., successor to Nancy Ann Dressed Dolls, moves the court for an order dismissing the above entitled cause, for reasons and upon grounds as follows:

1. This court is without jurisdiction because defendant Nancy Ann Storybook Dolls, Inc. is not within the jurisdiction or subject to the process of this court.

2. The Commissioner of Patents is only a nominal defendant, and is not an adverse party to the action within the contemplation of R. S. Sec. 4915, 35 U. S. C. A. Sec. 63 and 72a for the purpose of determining jurisdiction of the court.

3. Defendant Nancy Ann Storybook Dolls, Inc. has not been duly or properly served.

14 In support of said motion, defendant Nancy Ann Storybook Dolls, Inc. will rely upon the following points and authorities:

35 U. S. C. A. Sec. 63 (R. S. Sec. 4915).

35 U. S. C. A. Sec. 72a.

Coe, Commissioner of Patents vs. Hobart Mfg. Co. 102 F. 2nd 270.

J. C. Eno (U. S.) Limited vs. Coe, Commissioner of Patents, 106 F. 2nd 858.

Thorne, Neale & Co. Inc. vs. Coe, Commissioner of Patents, et al, 3 F. R. D. 259.

Dated: Washington, D. C.

March 12, 1948.

Raymond J. Mawhinney
Attorney for Nancy Ann
Storybook Dolls, Inc.

Charles S. Evans
Hugh N. Orr
Of Counsel.

* * * *

15 Filed Mar 15 1948 Harry M. Hull, Clerk

Motion to Dismiss

NOW COMES Defendant Lawrence C. Kingsland, Commissioner of Patents, and joins in the motion of defendant Nancy Ann Storybook Dolls, Inc., to dismiss the Complaint on the grounds set forth in the Motion and on the further ground that:

The Action cannot proceed against the Commissioner of Patents alone in the absence of the necessary party, Nancy Ann Storybook Dolls, Inc.

W. W. Cochran
Solicitor, U. S. Patent Office,
Attorney for Defendant
Lawrence C. Kingsland,
Commissioner of Patents.

March 15, 1948.

I hereby certify that a copy of this MOTION TO DISMISS, with accompanying Points and Authorities, has been mailed today, March 15, 1948, to the attorney for plaintiff, Mr. Herbert J. Jacobi, 966 National Press Building, Washington, D. C., and a copy to Mr. Raymond J. Mawhinney, 444 Munsey Building, Washington, D. C., attorney for Defendant Nancy Ann Storybook Dolls, Inc.

W. W. Cochran
Solicitor.

* * * *

16 Filed Apr 30 1948 Harry M. Hull, Clerk

Order

This cause came on to be heard on the motion of Defendant, Nancy Ann Storybook Dolls, Inc., to dismiss the complaint, and on the concurrent motion of Co-Defendant, Lawrence C. Kingsland, Commissioner of Patents, to dismiss the complaint and thereupon, upon consideration thereof it is this 30th day of April 1948,

ORDERED that the said motions be and they are hereby sustained and that the complaint be and it is hereby dismissed.

F. Dickinson Letts
Justice

* * * *

17 Filed May 28 1948 Harry M. Hull, Clerk

Notice of Appeal

Notice is hereby given that Gardel Industries, plaintiff in the above named action, hereby appeals to the United States Court of Appeals for the District of Columbia from the Order sustaining the defendants' Motions to Dismiss the Complaint, and dismissing the Complaint, entered in this action on April 30, 1948.

Herbert J. Jacobi
Herbert J. Jacobi
966 National Press Building
Washington 4, D. C.
Attorney for Plaintiff-
Appellant.

May 28, 1948.

* * * *

19 Filed Feb 20 1948 Harry M. Hull, Clerk
IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA
Gardel Industries, 42 Tiffany Place, Brooklyn 2, New York,
Plaintiff,

v.

Lawrence C. Kingsland, U. S. Patent Office, Washington,
D. C., as Commissioner of Patents, and
Nancy Ann Storybook Dolls, Inc., (Successor to Nancy Ann
Dressed Dolls), 1298 Post Street, San Francisco 9, Cali-
fornia, Defendants.

CIVIL ACTION No. 718-48
Under Section 4915, Revised Statutes.

Complaint

The plaintiff alleges and represents, as follows:—

1. The plaintiff, Gardel Industries, is a partnership composed of Benjamin Dresher and Samuel H. Geffner, with a factory and office for the transaction of business at 42 Tiffany Place, in the City of Brooklyn, County of Kings, State of New York, Postal Zone 2.

2. The defendant, Lawrence C. Kingsland, is the Commissioner of Patents of the United States of America, a resident and inhabitant of the District of Columbia, and he is sued herewith because of certain acts and things done by him, by virtue of the powers of his office, and in the course of the alleged performance of his duties as Commissioner of Patents.

3. The defendant, Nancy Ann Storybook Dolls, Inc., as plaintiff is informed, is a corporation organized and
20 existing under and by virtue of the Laws of the State of California, with an office for the transaction of business at 1298 Post Street, in the City of San Francisco, County of San Francisco, State of California, Postal Zone 9.

4. This Court has jurisdiction over this action, under the provisions of the Trade-Mark Act of 1905, as amended, under the Trade-Mark Act of 1946, under U. S. Code Title 35, Sec. 63, and under U. S. Code, Title 35, Sec. 72(a).

5. Since September, 1944, and continuously since that date, plaintiff has used as a trade-mark the arbitrary words "Birthstone Doll of the Month", as applied to dolls produced and sold by it in interstate commerce throughout the United States to designate origin of such merchandise in plaintiff and being the owner of said trade-mark and entitled to the exclusive use thereof, as applied to dolls, sold and distributed in interstate commerce throughout the United States, plaintiff on February 9, 1945, filed its application for registration of the trade-mark "Birthstone Doll of the Month" in the United States Patent Office, in

accordance with the Act of February 20, 1905; after due examination and compliance with the Laws, in such cases made and provided, and the Rules of Practice of the United States Patent Office, said trade-mark was favorably acted upon by the Examiner of Trade-Marks, duly passed to publication, and published in the Official Gazette of the United States Patent Office, dated April 17, 1945.

6. On or about May 7, 1945, Nancy Ann Dressed Dolls, a partnership, composed of Nancy Ann Abbott, Allen N. Roland and Frederick E. Andersen, predecessor of the defendant, Nancy Ann Storybook Dolls, Inc., of 1298 Post Street, San Francisco 9, California, filed opposition
21 to the registration of plaintiff's aforesaid trade-mark, alleging ownership of twelve registered trade-marks covering the words "January Girl", "February Girl", "March Girl", etc. (one for each month of the year), and also alleging ownership of pending applications for registration of alleged trade-marks "Birthday Doll" and "Dolls of the Month", and still further alleging confusing similarity between the mark of the plaintiff and the alleged marks of said defendant. Said opposition proceeding was titled Nancy Ann Dressed Dolls v. Gardel Industries, Opposition No. 24,256; and after plaintiff filed answer on June 20, 1945, to the Notice of Opposition, testimony was taken by both parties and duly made of record in the United States Patent Office.

7. Following the taking of testimony, there having been recorded in the Title Division of the United States Patent Office an assignment, dated January 7, 1946, purporting to transfer all trade-marks and good will from Nancy Ann Dressed Dolls, a partnership, to Nancy Ann Storybook Dolls, Inc., a California corporation, the United States Patent Office, on motion of the opposer, substituted said Nancy Ann Storybook Dolls, Inc., as assignee-opposer, the proceeding being thereafter titled: Nancy Ann Dressed Dolls (Nancy Ann Storybook Dolls, Inc., assignee, substituted) v. Gardel Industries, Opposition No. 24,256.

S. A hearing was had before the Examiner of Trade-Mark Interferences on April 12, 1946, and on August 7, 1946, said Examiner of Interferences rendered a decision dismissing the opposition and adjudging Gardel Industries, plaintiff herein, entitled to the registration for which it made application. Defendant duly took an appeal from said decision to the Commissioner of Patents and
22 after hearing on May 15, 1947, before said tribunal, the First Assistant Commissioner rendered a decision, dated August 21, 1947, reversing the decision of the Examiner of Interferences.

G. The plaintiff herein has taken no appeal to the United States Court of Customs and Patent Appeals from the aforesaid decision of the First Assistant Commissioner of Patents.

10. Plaintiff is engaged in the manufacture and sale of dolls and since September, 1944, has adopted and used in connection with the sale of certain of its dolls the original and arbitrary trade-mark "Birthstone Doll of the Month", the same being displayed on a tag attached to the dolls, and also utilizing in connection with said dolls certain birthstones, as representing months of the year within which birthdays occur. Large sums of money have been expended by plaintiff in advertising the dolls under its original and arbitrary trade-mark "Birthstone Doll of the Month" and the public has come to recognize dolls bearing said trade-mark as originating with the plaintiff. As plaintiff is informed and believes and, therefore, charges the fact to be, no other manufacturer or distributor of dolls, including the defendant, has used the same or a confusingly similar trade-mark on dolls, from a date prior to plaintiff's first date of use of said trade-mark.

11. The defendant, Nancy Ann Storybook Dolls, Inc., and its predecessors from whom title is alleged to have been derived, claim ownership of certain prior registrations of trade-marks referring to months of the year, such as "January Girl", "February Girl", "March Girl", etc., as applied to dolls, but if defendant owns such trade-

marks and has had prior use thereof, it is not damaged by the registration of plaintiff's aforesaid trade-mark, in that the latter is not confusingly similar to defendant's said marks. Defendant also claims prior use and ownership of alleged trade-marks "Birthday Dolls" and "Dolls of the Month", but plaintiff avers that defendant has not shown nor legally proven use of said trade-marks from a date prior to the first date of use by plaintiff of its aforesaid trade-mark, so that defendant cannot be damaged, within the meaning of the Trade-Mark Law, by the registration of plaintiff's aforesaid trade-mark.

12. Plaintiff further avers that its trade-mark "Birthstone Doll of the Month" is distinctively and registrably different from any trade-mark legally owned and used by the defendant, and/or its predecessors, from any date prior to the first date of use by plaintiff of its trade-mark aforesaid.

13. The defendant, Lawrence C. Kingsland, acting as Commissioner of Patents, notwithstanding the facts and evidence, has reversed the decision of the Examiner of Interferences dismissing the opposition of the defendant, thereby denying plaintiff registration of its trade-mark, to the great and irrevocable injury of plaintiff for which it has no remedy at law.

Plaintiff, therefore, prays for the following relief:—

A. That judgment be granted in favor of plaintiff adjudging that plaintiff is the sole and exclusive owner of the trade-mark "Birthstone Doll of the Month" and that said trade-mark is distinctively and registrably different from any trade-mark owned and used by the defendant, Nancy Ann Storybook Dolls, Inc.

B. That plaintiff was the first to adopt and use the trade-mark "Birthstone Doll of the Month" as applied to dolls sold in interstate commerce throughout the United States and that defendant has not proven use of its alleged trade-marks "Birthday Dolls" and "Dolls of the Month" from a date prior to the date of

first use by plaintiff of its aforesaid trade-mark.

C. That plaintiff's trade-mark does not resemble defendant's registered trade-marks or any other valid trade-marks of the defendant of which it may have had priority.

D. That the defendant's alleged trade-mark "Dolls of the Month" is merely a descriptive expression, not capable of exclusive appropriation.

E. That judgment be granted holding plaintiff's trade-mark "Birthstone Doll of the Month", with the descriptive words "Doll of the Month" disclaimed, is registrable and that the opposition in the United States Patent Office by the defendant should be dismissed.

F. That a writ be issued under U. S. Code, Title 35, Sec. 72(a), against the defendant, Nancy Ann Storybook Dolls, Inc., and that such other and further relief be granted as may be deemed proper.

Gardel Industries,
By Herbert J. Jacobi
By Herbert J. Jacobi
966 National Press Building
Washington 4, D. C.
Attorney for Plaintiff.

February 20, 1948.

25 Summons in a Civil Action D. C. Form No. 45 Rev.

Received Feb 24 1948

U. S. Marshal's Office, San Francisco, Calif.

Civil 28269

DISTRICT COURT OF THE UNITED STATES

For The

District of Columbia

Civil Division

Civil Action File No. 718-48

Gardel Industries, Plaintiff

v.

Lawrence C. Kingsland, Commissioner of Patents

Nancy Ann Storybook Dolls, Inc.

(Successor to Nancy Ann Dressed Dolls)

Defendant

SUMMONS

To the above named Defendant: Nancy Ann Storybook
Dolls, Inc. (Successor to Nancy Ann Dressed Dolls)

You are hereby summoned and required to serve upon
Herbert J. Jacobi

plaintiff's attorney, whose address is 966 National Press
Building, Washington, D. C.

an answer to the complaint which is herewith served upon
you, within 20 days after service of this summons upon
you, exclusive of the day of service. If you fail to do so,
judgment by default will be taken against you for the relief
demanded in the complaint.

Harry M. Hull

Clerk of Court

By Anna M. Thompson

Deputy Clerk

Date: Feb. 20, 1948

(Seal of Court)

Note.—This summons is issued pursuant to Rule 4 of
the Federal Rules of Civil Procedure.

26 RETURN ON SERVICE OF WRIT

I hereby certify and return, that on the 25th day
of February 1948, I received the within summons and
Complaint and served the same on Nancy Ann Storybook
Dolls, Inc. by serving A. L. Rowland as Secretary at San
Francisco California on the 25th day of February 1948.

George Vice

United States Marshal

By Herbert R. Cole

Deputy United States
Marshal

Marshal's Fees

Travel \$

Service 2.00

* * * *

29 Filed Mar 10 1948 Harry M. Hull, Clerk

Motion to Dismiss

Defendant Nancy Ann Storybook Dolls, Inc., successor to Nancy Ann Dressed Dolls, moves the court for an order dismissing the above entitled cause, for reasons and upon grounds as follows:

1. This court is without jurisdiction because defendant Nancy Ann Storybook Dolls, Inc. is not within the jurisdiction or subject to the process of this court.

2. The Commissioner of Patents is only a nominal defendant, and is not an adverse party to the action within the contemplation of R. S. Sec. 4915, 35 U. S. C. A. Sec. 63 and 72a for the purpose of determining jurisdiction of the court.

3. Defendant Nancy Ann Storybook Dolls, Inc. has not been duly or properly served.

30 In support of said motion, defendant Nancy Ann Storybook Dolls, Inc. will rely upon the following points and authorities:

35 U. S. C. A. Sec. 63 (R. S. Sec. 4915).

35 U. S. C. A. Sec. 72a.

Coe, Commissioner of Patents vs. Hobart Mfg. Co. 102 F. 2nd 270.

J. C. Eno (U. S.) Limited vs. Coe, Commissioner of Patents, 106 F. 2nd 858.

Thorne, Neale & Co. Inc. vs. Coe, Commissioner of Patents, et al, 3 F. R. D. 259.

Dated: Washington, D. C.

March 10, 1948.

Raymond J. Mawhinney
Attorney for Nancy Ann
Storybook Dolls, Inc.

Charles S. Evans
Charles S. Evans
Hugh N. Orr
Hugh N. Orr
Of Counsel.

• • • •

31 Filed Mar 10 1948 Harry M. Hull, Clerk

Notice of Motion to Dismiss

To Gardel Industries, Plaintiff above named, and to Herbert J. Jacobi, its attorney:

To Lawrence C. Kingsland, Commissioner of Patents, Defendant above named, and to W. W. Cochran, Solicitor of the U. S. Patent Office, his attorney:

You and each of you will please take notice that on Monday, the 12th day of April, 1948, in the courtroom of the above entitled court in the Court House Building, Washington, D. C., at the hour of 9:45 O'clock A. M. or as soon thereafter as counsel can be heard, defendant will present the accompanying Motion to Dismiss.

Dated: Washington, D. C.

March 10, 1948.

Raymond J. Mawhinney
Attorney for
Storybook Dolls, Inc.
Raymond J. Mawhinney
444 Munsey Building
Washington, D. C.

32 Filed Mar 10 1948 Harry M. Hull, Clerk

Due service and receipt of a copy of the above Notice of Motion to Dismiss and of the accompanying Motion to Dismiss is acknowledged this 10th day of March, 1948.

Herbert J. Jacobi
Attorney for Gardel
Industries.
W. W. Cochran
Solicitor, U. S. Patent Office

* * * *

33 Filed Mar 12 1948 Harry M. Hull, Clerk

Motion to Dismiss

NOW COMES Defendant Lawrence C. Kingsland, Commissioner of Patents, and joins in the motion of defendant Nancy Ann Storybook Dolls, Inc., to dismiss the Complaint on the grounds set forth in the Motion and on the further ground that:

The Action cannot proceed against the Commissioner of Patents alone in the absence of the necessary party, Nancy Ann Storybook Dolls, Inc.

W. W. Cochran
Solicitor, U. S. Patent Office
Attorney for Defendant
Lawrence C. Kingsland,
Commissioner of Patents.

March 12, 1948.

I hereby certify that a copy of this MOTION TO DISMISS, with accompanying Points and Authorities, has been mailed today, March 12, 1948, to the attorney for plaintiff, Mr. Herbert J. Jacobi, 966 National Press Building, Washington, D. C., and a copy to Mr. Raymond J. Mawhinney, 444 Munsey Building, Washington, D. C., attorney for Defendant Nancy Ann Storybook Dolls, Inc.

W. W. Cochran
Solicitor.

• • • •

34 Filed Apr 30 1948 Harry M. Hull, Clerk

Order

This cause came on to be heard on the motion of Defendant, Nancy Ann Storybook Dolls, Inc., to dismiss the complaint, and on the concurrent motion of Co-Defendant, Lawrence C. Kingsland, Commissioner of Patents, to dismiss the complaint and thereupon, upon consideration thereof it is this 30th day of April 1948,

ORDERED that the said motions be and they are hereby sustained and that the complaint be and it is hereby dismissed.

F. Dickinson Letts
Justice

* * * *

35 Filed May 28 1948 Harry M. Hull, Clerk

Notice of Appeal

Notice is hereby given that Gardel Industries, plaintiff in the above named action, hereby appeals to the United States Court of Appeals for the District of Columbia from the Order sustaining the defendants' Motions to Dismiss the Complaint, and dismissing the Complaint, entered in this action on April 30, 1948.

Herbert J. Jacobi
Herbert J. Jacobi
966 National Press Building
Washington 4, D. C.
Attorney for Plaintiff-
Appellant

May 28, 1948.

Nos. 9911, 9912

SUPPLEMENTAL BRIEF FOR APPELLANT

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 9911

GARDEL INDUSTRIES, *Appellant*,

vs.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

No. 9912

GARDEL INDUSTRIES, *Appellant*,

vs.

LAWRENCE C. KINGSLAND, as Commissioner of Patents,
et al., *Appellees*.

**Appeal from the United States District Court
for the District of Columbia**

HERBERT J. JACOBI,
966 National Press Building
Washington 4, D. C.
Attorney for Appellant.

WILSON - EPES PRINTING CO. - RE 6003 - WASHINGTON 1, D. C.

*United States Court of Appeals
For the
District of Columbia Circuit*

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United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Nos. 9911-2

GARDEL INDUSTRIES, *Appellant*,

vs.

LAWRENCE C. KINGSLAND, Commissioner of Patents,
and
NANCY ANN STORY BOOK DOLLS, INC., *Appellees*

Appeal from the United States District Court
for the District of Columbia

SUPPLEMENTAL BRIEF FOR APPELLANT

The consolidated appeals in this case were argued before the Honorable Court of Appeals on October 6, 1949. Prior to that date the appellees, Lawrence C. Kingsland, Commissioner of Patents, and Nancy Ann Story Book Dolls, Inc., had each filed supplemental briefs in this case. During the argument before the Honorable Court, counsel for appellant in attempting to refute the arguments advanced, particularly in the supplemental briefs of the two appellees, referred to several decisions and several portions of the controlling statutes. Counsel was admonished by the Court that, if consideration were to be given by the Court to any authorities not mentioned in appellant's

original brief, a supplemental brief must be filed. The present supplemental brief is filed in compliance with this admonition.

SUPPLEMENTAL STATEMENT OF POINTS

In addition to the points noted at pages 8 and 9 of appellant's main brief, Gardel Industries further submits—

(a) The decision of this Court in the case of *Barron-Gray Packing Company v. Kingsland* 79 USPQ 100 (certiorari denied April 4, 1949, 81 USPQ; 81 USPQ; advance sheet 81 USPQ No. 2 April 9, 1949, page III) is controlling in the present case.

(b) That consonant with the decision of the *Barron-Gray Packing Company v. Kingsland*, the appellee, Nancy Ann Story Book Dolls, Inc. is a proper but not an indispensable party in trade-mark proceedings arising under RS 4915.

(c) The decision of this Court in the case of *Barron-Gray Packing Co.*, affirming this Court's decision in the case of *Tomlinson of Highpoint v. Coe* (74 App. D. C. 364; 51 USPQ 249), holds that the Commissioner of Patents is a proper and indispensable party in proceedings under RS 4915 since the public interest cannot properly be served without the participation of the Commissioner.

(d) That appellant's applications for registration of its trade-marks were filed in the Patent Office on or about February 5, 1945 seeking registration under the provisions of the Trade-Mark Act of 1905, as amended, and prior to the enactment or effective date of the Trade-Mark Act of 1946. (U. S. Code Title 15, sections 1015 et seq.).

(e) That, since the decision of the Supreme Court of the United States in the case of *American Steel Foundries vs. Robertson* 262 US. 209, it has been recognized that the proceeding by bill in equity under RS 4915 is part of the

application for registration of a trade-mark and is a remedy available to an applicant seeking registration under the Act of 1905, being a remedy accorded by Section 9 of the Act of Feb. 20, 1905 (U. S. Code Title 15, section 89).

(f) The Trade-Mark Act of July 5, 1946 (U. S. Code Title 15, section 1015 et seq.) does not repeal or extinguish the rights or remedies accorded to appellant under the Trade-Mark Act of Feb. 20, 1905.

(g) Section 21 of the Act of July 5, 1946 (U. S. Code Title 15 Section 1071) is not applicable to the present controversy.

(h) Section 46 (a) of the Act of July 5, 1946 (Footnote U. S. Code Annotated, Title 15 Section 1051, page 292) is controlling in the present suit. This section of the Act in part states "This Act shall be in force and take effect one year from its enactment, but except as otherwise herein specifically provided shall not affect any suit, *proceeding*, or appeal then pending." * Further, Section 46 (a) states "Provided, that this repeal shall not affect the validity of *registrations* granted or *applied for* under any of said Acts *prior to the effective date of this Act, or rights or remedies thereunder except as provided in Sections 8, 12, 14, 15, and 47 of this Act.*" *

(i) Section 47 (a) of the Act of July 5, 1946 (Footnote U. S. Code Annotated, Title 15, Section 1051, page 292) permits the amendment of an application for registration to bring it under the provisions of the Act of 1946 and then goes on to state "If such amendments are not made, the *prosecution* of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and *said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof.*" *

* Italics added.

(j) The right to bring a suit under RS 4915, granted to an applicant for registration under the Act of Feb. 20, 1905, is *part of the proceeding* for the registration of a trade-mark recognized by the Supreme Court in *American Steel Foundries vs. Robertson supra*. It is a *remedy and a right* recognized in the "proviso" in section 46 (a) of the Trade-Mark Act of July 5, 1946. It is part of the *prosecution* of an application for registration under the Act of 1905 which is continued in force and effect in accordance with Section 47 (a) of the Act of July 5, 1946. It is a *proceeding* which is not extinguished by the enactment of the Act of July 5, 1946 in accordance with the first sentence of Section 46 (a) of said Act.

ARGUMENT

Two primary questions and one collateral question are presented for determination in this case. *The first primary question* is: prior to the enactment of the Trade-Mark Act of July 5, 1946, did an unsuccessful applicant for trade-mark registration have the right to sue the Commissioner of Patents in the United States District Court for the District of Columbia under the provisions of RS 4915? This question was answered affirmatively by this Court in two fairly recent decisions. *Tomlinson vs. Coe, supra* and *Barron-Gray vs. Kingsland, supra*. In the Tomlinson case this Court held:

"The proceeding by bill in equity under Section 4915 R. S. is 'a part of the application for the patent, or for registration of the trade mark'. Accordingly, in the present case, appellant seeks relief which is properly sought under the provisions of Section 4915, R. S., i.e., a decree authorizing and directing the Commissioner of Patents to register its trade mark. Both the public interest and the necessities of the case *require* that the Commissioner be made a party when the issue to be determined is whether such relief shall be granted. *The opposer could not act to carry out*

a decree granting such relief; and such relief should not be granted without opportunity for the Commissioner to present countervailing evidence; hence, the public interest cannot properly be served without the participation of the Commissioner. (Italics supplied)."

In the *Barron-Gray* case, this Court, affirming and quoting with approval its holding quoted above, expressly held that the District Court does have jurisdiction to proceed against the Commissioner alone in a suit brought under R. S. 4915.

Collaterally, this Court held in the *Barron-Gray* decision that the opposer is a proper, but not an indispensable party, in an action under R. S. 4915. As such, the successful opposer may elect to appear, but the rights of the appellant should not be defeated by reason of the failure or refusal of the opposer to appear. Accordingly, the appellee, Nancy Ann Story Book Dolls, Inc. may refuse to appear, but such refusal cannot defeat applicant's rights to prosecute its suit against the Commissioner in the District of Columbia.

The *second primary question* for determination is: did the enactment of the Trade-Mark Act of July 5, 1946 abolish the theretofore recognized right of an unsuccessful applicant (for registration under the Trade-Mark Act of February 20, 1905) to sue the Commissioner in the District of Columbia under the provisions of R. S. 4915?

The last sentence of Section 21 of the Act of July 5, 1946, provides, in part, that the Commissioner of Patents shall not be a necessary party to an inter-parties proceeding under Revised Statutes 4915, but shall have the right to intervene in the action. Section 21 of the Act of July 5, 1946 is not controlling in the present case.

Section 47 (a) of the Act of July 5, 1946 gives an election to any applicant for registration whose application was pending in the Patent Office prior to the effective date

of the Act (July 5, 1947). The applicant can, but is not required to, amend his application so as to bring it in accordance with the provisions of the Act of 1946. Section 47(a) additionally provides that if such amendments are *not* made, the prosecution of the application shall be proceeded with and registrations granted thereon in accordance with the Acts under which said applications were filed; and "said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof."

Section 46 (a) of the Act of July 5, 1946 provides that the Act shall be in force and take effect one year from its enactment, but except as otherwise specifically provided *shall not effect any suit, proceeding, or appeal then pending*. Further, in Section 46 (a) there is a proviso which states that this repeal shall *not* affect the validity of registrations granted or *applied for* under any of said Acts (including the Act of Feb. 20, 1905) prior to the effective date of this Act or rights or remedies thereunder, except as provided in Sections 8, 12, 14, 15 and 47 of this Act. The "right or remedy" of "a registration applied for" includes, within the meaning of this proviso, a right to bring suit under the provisions of R. S. 4915.

The right to bring suit included the right to sue the Commissioner of Patents within the jurisdiction of the United States District Court for the District of Columbia. This right was extended by Section 9 of the Act of Feb. 20, 1905 and was recognized by numerous decisions of this Court, including the *Tomlinson* case, which squarely held that the right or remedy (of an applicant for registration applied for under the Act of Feb. 20, 1905) to sue under R. S. 4915 is but part of the proceedings for obtaining registration. This was initially recognized by the United States Supreme Court in *Gandy vs. Marble* 122 U. S. 432. The decision of Justice Blachford in that case was quoted and approved by the United States Supreme Court in its

later decision of *American Steel Foundries v. Robertson* 262 U. S. 209, which held that a bill in equity under R. S. 4915 is only part of the proceeding for an application for registration of a trade-mark. The Court's holding in this latter case was quoted with approval on page 6 of the main brief of appellee, Nancy Ann Story Book Dolls, Inc. The identical holding is categorically set forth in this Court's decision in *Tomlinson of Highpoint v. Coe* and was quoted with approval in this Court's decision in *Barron-Gray Packing Co. vs. Kingsland supra*.

Since the bill in equity is part of the application for registration of the trade-mark, as recognized by the Courts, it is "part of the prosecution of the application" in accordance with Section 47 (a) of the Act of July 5, 1946, which may be proceeded with in accordance with the Acts under which the applications were filed. The Act of Feb. 20, 1905 was, therefore, continued in force for this purpose notwithstanding the general repeal thereof. If there are any doubts as to this point, the doubts would seem to be resolved by the significant omission of Section 21 of the Act of July 5, 1946 in the list of excepted sections which appear in the proviso of section 46 (a) of the Act of July 5, 1946.

CONCLUSION

In the light of the points and authorities above noted and for each and all of the reasons indicated, it is submitted that the United States District Court for the District of Columbia had, and has, jurisdiction to hear the actions herein involved, clearly with respect to the defendant, the Commissioner of Patents, and that the order dismissing said actions as to the defendant, the Commissioner of Patents, should be reversed. As to the defendant, Nancy Ann Story Book Dolls, Inc., the order dismissing the action may be affirmed if that defendant elects not to appear and place itself within the jurisdiction of the

Court. Such dismissal should not defeat appellant's rights to proceed against the Commissioner of Patents. The defendant, Nancy Ann Story Book Dolls, Inc., is a proper but not indispensable party. The Commissioner of Patents is a proper and indispensable party.

Respectfully submitted,

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No. 9911-12

**BRIEF FOR APPELLEE—NANCY ANN STORYBOOK
DOLLS, INC.**

United States Court of Appeals

DISTRICT OF COLUMBIA CIRCUIT

No. 9911

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, AS COMMISSIONER OF PATENTS,
ET AL., *Appellees*.

No. 9912

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, AS COMMISSIONER OF PATENTS,
ET AL., *Appellees*.

Appeal from the District Court of the United States
for the District of Columbia

United States Court of Appeals
for the District of Columbia
Circuit

FILED SEP 27 1948

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United States Court of Appeals

DISTRICT OF COLUMBIA CIRCUIT

Nos. 9911 - 12

GARDEL INDUSTRIES, *Appellant*,

VS.

LAWRENCE C. KINGSLAND, AS COMMISSIONER OF PATENTS,
NANCY ANN STORYBOOK DOLLS, INC., *Appellees*.

**Appeal from the District Court of the United States
for the District of Columbia**

BRIEF FOR APPELLEE, NANCY ANN STORYBOOK DOLLS, INC.

Appellant, Gardel Industries has appealed to this court from orders made and entered by the United States District Court for the District of Columbia, dismissing its complaints in Civil Actions No. 717-48 and No. 718-48. The suits were alleged to be brought under Sec. 4915 R. S. (U. S. C. Title 35, Sec. 63). Lawrence C. Kingsland, as Commissioner of Patents, and Nancy Ann Storybook Dolls, Inc. were named defendants.

Only a few simple questions are involved, all of which may be readily answered by applying the statutory law to the facts of these cases. No new principle of law is involved; nor it is necessary to resort to fine distinctions or abstruse reasoning to find conclusive answers, soundly

based on the law, and supported by prior decisions of the courts in cases of generally similar character. In the following pages, appellee Nancy Ann Storybook Dolls, Inc. will strive to accurately highlight the essential factors upon which the cases are to be decided.

JURISDICTION

Jurisdiction of this court to hear and decide these appeals is not questioned. The primary issue is whether or not the decision of the U. S. District Court for the District of Columbia, dismissing the complaints as to both defendants, for lack of jurisdiction, was correct. Appellee, Nancy Ann Storybook Dolls, Inc. submits that the decisions were sound and should be affirmed.

STATUTES

Appellant has quoted in its brief most of the statutory provisions upon which the present case depends. Its construction of some of the material portions of those statutes is untenable in several respects, which appellee will point out and discuss in the ensuing argument.

FACTS AND STATEMENT OF CASE

Appellant opens its statement of the case with a number of allegations which are contrary to the facts and the decision of the Assistant Commissioner of Patents, based on the evidence presented by the parties in proceedings before the Patent Office. The fallacies which inevitably spring from a false premise are traceable throughout appellant's brief. At the outset, appellant alleges adoption and use, "as sole and exclusive owner" of two allegedly "original, arbitrary and distinctive trade-marks" for dolls, namely

“Birthstone Doll” and “Birthstone Doll of the Month” as to which it claims to be “entitled to exclusive right”. The assertion of such use, ownership, and exclusive right by appellant was questioned by Nancy Ann Dressed Dolls, as to whose rights and interest appellee Nancy Ann Storybook Dolls, Inc. has been substituted in the present proceedings. Opposition proceedings were regularly instituted; and the Opposer alleged ownership of the following registered trade-marks, each identified with the name of a month of the year, just as the various “Birthstones” are identified with the names of particular months of the year:

January Girl,	Reg. No. 403,256 dated September 14, 1943
February Girl,	Reg. No. 403,257 dated September 14, 1943
March Girl,	Reg. No. 403,258 dated September 14, 1943
April Girl,	Reg. No. 403,259 dated September 14, 1943
May Girl,	Reg. No. 403,260 dated September 14, 1943
June Girl,	Reg. No. 403,261 dated September 14, 1943
July Girl,	Reg. No. 403,262 dated September 14, 1943
August Girl,	Reg. No. 403,263 dated September 14, 1943
September Girl,	Reg. No. 403,224 dated September 14, 1943
October Girl,	Reg. No. 403,225 dated September 14, 1943
November Girl,	Reg. No. 403,226 dated September 14, 1943
December Girl,	Reg. No. 394,455 dated May 26, 1942

In addition, the opposer alleged prior use of the trade-marks “Birthday Dolls” and “Dolls of the Month”. These two marks were the subjects of applications for registration. “Birthday Dolls” in due course was registered. Certificate No. 426,526, dated December 31, 1946 was issued; and is now owned by appellee, Nancy Ann Storybook Dolls, Inc. Application for registration of the mark “Dolls of the Month” is still pending before the Patent Office on an application filed June 7, 1943, alleging use since January 1, 1941.

The facts are that, prior to appellant’s entry into the field, appellee, Nancy Ann Storybook Dolls, Inc., by its predecessors, had adopted and used the marks “Birthday Dolls”, “Dolls of the Month”, and “January—”, “Febru-

ary —", etc. "December—Girl". All of these marks are definitely identified with the months of the year, as also are appellant's "Birthstone" and "Birthstone Doll of the Month". The patent office, by the Assistant Commissioner, has ruled that the marks which appellant has sought to register are confusingly like those of appellee, Nancy Ann Storybook Dolls, Inc., and are reasonably likely to cause confusion in the trade, with consequent damage to appellee. Jurisdiction of the patent office tribunals has been exhausted.

Appellant had a definite statutory right to appeal from the decision of the Commissioner of Patents to the U. S. Court of Customs and Patent Appeals (U. S. C. Title 35 Sec. 89); but did not exercise that right. In such an appeal, there would be no question of jurisdiction. Both opposing parties would be entitled to be represented, for briefing and arguing the appeal; and the Commissioner of Patents would occupy the position of a trial court from whose decision an appeal is taken to a proper court of appeals. Instead, appellant elected to file its complaints in the U. S. District Court for the District of Columbia, in reliance upon Section 4915 of the Revised Statutes, (U. S. C. Title 35, Sec. 63).

The complaints (1A — 6A; 11A — 16A)* were served on the Commissioner of Patents, in the District of Columbia. Copies of the complaints were served upon defendant Nancy Ann Storybook Dolls, Inc. at San Francisco, California, where its offices and principal place of business is located. Both defendants made timely motions to dismiss. The motions of defendant Nancy Ann Storybook Dolls, Inc. (9A and 18A) were based upon the grounds that it is an indispensable party to the actions; and, that because its legal residence is at San Francisco, California, and it is

* References are to Joint Appendix to Appellant's Brief.

not properly within or subject to the jurisdiction of the U. S. District Court for the District of Columbia, where the actions were brought, the actions should be dismissed.

The motions of the Commissioner of Patents (10A and 20A) were grounded on the position that the Commissioner is merely a formal or nominal party, and that in the absence of the opposer, as an indispensable party, the proceedings should be dismissed.

The motions of both defendants in both cases were argued together; and upon April 30, 1948, orders (10A — 11A; 20A — 21A) were issued by the U. S. District Court, sustaining the motions of both defendants, and dismissing the complaints, as to both parties defendant.

STATEMENT OF POINTS

Defendant Nancy Ann Storybook Dolls, Inc. opposes appellant on each of the points stated in appellants brief; and submits that the decisions and orders appealed from are *not* erroneous in any of the respects stated by appellant, or otherwise. The U. S. District Court correctly ruled:

1. That defendant Nancy Ann Storybook Dolls, Inc. is an *indispensable party*, not within the jurisdiction of the Court.
2. That defendant the Commissioner of Patents is *not* an indispensable party.
3. That the actions cannot proceed in the absence of the *indispensable* defendant, Nancy Ann Storybook Dolls, Inc.
4. That the motions of the defendants should be sustained, and the actions dismissed.

ARGUMENT

Appellee Nancy Ann Storybook Dolls, Inc. earnestly submits that the decisions and orders of the U. S. District Court for the District of Columbia in these cases should be affirmed. If any uncertainty exists, it is due to the cumulative effect of a number of decisions in which the Courts, including the Supreme Court of the United States, have leaned backward to insure applicants for patents and for registration of trade-marks every possible right extended or possibly intended to be extended by R. S. Section 4915, (U. S. C. Title 35, Sec. 63). As a matter of fact, that section by its terms does not extend to applicants for registration of trade-marks; and it is only by a very liberal interpretation by the Courts of Sec. 9 of the Trade-Mark Act of February 20, 1905, (U. S. C. Title 15, Sec. 89) that an applicant in the position of the present appellant has been given any right to proceed under R. S. 4915. Thus in *American Steel Foundries vs. Robertson, et al* 262 U. S. 209, 43 S. Ct. 541, the Supreme Court of the United States quoted from Sec. 9 of the Trade-Mark Act of February 20, 1905 and commented thereon as follows:

“‘and the same rules of practice and procedure shall govern in every stage of such proceedings as far as the same may be applicable.’ If the bill in equity of section 4915 is only a part of the proceeding for an application for a patent as held in *Gandy v. Marble*, it is no straining of the language to make these words include a bill in equity for the registration of a trade-mark.”

Since that time, proceedings under the provisions of R. S. 4915 have been held to be available to applicants for registration for Trade-marks.

Broadly, there have been two classes of trade-mark cases under R. S. 4915: (1) those which are prosecuted “ex-parte” in which only the rights of the applicant, and the

duty of the Commissioner to register, are involved; and (2) those conducted as "inter-partes" proceedings in which the rights of two opposing parties are involved. In the latter class of cases, the Commissioner acts firstly in a quasi judicial capacity to resolve, if possible, the dispute between contesting parties; and secondly as an administrative officer, authorized to carry into effect, in conformity with other factors, the judgment of the courts, upon the facts of each individual case.

As to "ex-parte" cases, the Commissioner represents the public interest, and is the sole defendant. His official residence being at Washington, D. C., the U. S. District Court for the District of Columbia is unquestionably the proper forum in which such issues are to be determined; and the law requires that the complaint be served upon him.

"Inter-partes" cases present a different situation. The Commissioner of Patents, having passed favorably upon the application of an applicant, for registration of a trade-mark, is required to publish the mark, so that anyone "who believes he would be damaged by the registration of a mark may oppose the same". (U. S. C. Title 15, Sec. 86; Act of Feb. 20, 1905, Sec. 6). Where, as in the present cases, opposition is filed, it becomes the duty of the Commissioner of Patents, acting through the Examiner of Interferences, to determine whether the facts presented by the opposer bar the registration which is opposed. In such cases, the opposer, as a member of the general public, having interests which may be adversely affected, takes over the responsibility of protecting the public interest.

The public interest requires that no trade-mark be registered which is reasonably likely to confuse the minds of the purchasing public as to the source of the purchased goods. As one of the general public, with special interests which may be affected, the opposer is given the right to present evidence, showing that confusion is reasonably

likely to occur, and that the opposer is likely to be specifically damaged by such confusion. The Commissioner is obligated to evaluate the evidence presented; and to adhere to or modify his ruling on the application in conformity with his findings. The Examiner of Interferences initially decides each case; subject to appeal to the Commissioner of Patents. The decision of the Commissioner of Patents represents the final conclusions of the Patent Office with respect to the public interest, as well as the private interests of the opposing party.

As a guard against arbitrary action by the patent office tribunals, a right of appeal to a tribunal outside the patent office is provided by law. Under present law, such appeal may be directly to the U. S. Court of Customs and Patent Appeals. Alternatively, relief by action in equity under R. S. 4915 (U. S. C. Title 35, Sec. 63) has been made available, as above discussed.

In either event, the Commissioner will have exhausted his original jurisdiction; and his decision will remain final unless and until a court outside the patent office rules otherwise. On a direct appeal to the U. S. Court of Customs and Patent Appeals, the court has jurisdiction to affirm, modify or reverse the decision of the Commissioner, just as in the case of an appeal to any appellate court from the decision of a lower tribunal. In such an appeal, the Commissioner is not a party defendant. The Court determines the case upon the record produced by the parties in the Patent Office proceeding; and, subject to other factors not involved in the appeal, the Commissioner of Patents is in duty bound to abide by the decision of the Court.

It sometimes happens that one or the other or both parties feel that the record produced in the patent office proceeding does not adequately prove the facts. In such an event, either party may seek the judgment of the U. S. District Court by suit in equity under R. S. 4915 (U. S. C.

Title 35, Sec. 63). The appellant may elect to bring such action; or, if appellant appeals to the U. S. Court of Customs and Patent Appeals, the appellee, upon proper notice, may require that the further proceedings be conducted under R. S. 4915. In either case, the record produced in the patent office proceedings may be introduced in whole or in part by either party, but without prejudice to the introduction of additional evidence, or the further examination of witnesses. Such a proceeding is obviously on *inter partes* proceeding; in which the Commissioner is at most only a nominal party.

By its terms, the statute (R. S. 4915, U. S. C. Title 35, Sec. 63) provides for judgment by the "court having cognizance thereof", which obviously can only be a court having jurisdiction of the indispensable parties. *Where there is no opposing party*, "a copy of the complaint must be served on the Commissioner". The statute does *not* require service on the Commissioner where, as here, there is an *opposing party*.

The judgment of the court in such a proceeding "if it be in favor of the right of the applicant, shall *authorize* the Commissioner to issue such patent (or register such trademark), *on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law*". In other words, the judgment is not a *mandate requiring* the Commissioner to issue a patent or certificate of registration. Instead, it merely *authorizes* the issuance, upon the filing of a copy of the adjudication and compliance with other requirements of law.

Since the adjudication is not a *mandate*, the Commissioner is *not* an *indispensable* party. As an administrative officer, the jurisdiction of the Commissioner extends to all parts of the United States. The adjudication of *any* U. S. Court having competent jurisdiction, of the opposing par-

ties, duly filed in the patent office (whether the Commissioner of Patents has been made a party or not) will *authorize* the Commissioner to issue the patent or certificate of registration of a trade-mark involved in the proceeding, providing other requirements of law are met. In other words, the court does not *order* the grant of a patent or the registration of a trade-mark in any event; but only authorizes the grant or registration, if it is otherwise permissible.

A refusal of the Commissioner to abide by such a judgment might warrant further proceedings for a writ of mandate in an action directed against the Commissioner. Counsel for appellee, Nancy Ann Storybook Dolls, Inc., knows of no instance in which such a proceeding has been necessary.

APPELLANTS AUTHORITIES

As a matter of statutory law, there is nothing to support appellant's theory that the Commissioner of Patents is an indispensable party in the present cases. Appellee, Nancy Ann Storybook Dolls, Inc. does not contend that the Commissioner of Patents is not a *proper* party; but does contend that the Commissioner is *not* an *indispensable* party. The authorities relied upon by appellant do not support its position in that regard

Tomlinson of High Point v. Coe, 123 F. 2nd. 65.

One of the authorities primarily relied upon by the appellant in the present cases is the decision of this case in *Tomlinson of High Point v. Coe*, 123 F. 2nd 65. In its decision in that case, this Court specifically stated the issue there involved as follows:

"The opposer, Colonial Williamsburg, Inc., was not joined as a defendant. The District Court granted the Commissioner's motion to dismiss the complaint on

the ground that he was not a *proper party* to the suit. That is the *only question* presented on this appeal”*

The opposer in the Patent Office proceedings was *not* named as a defendant in the complaint filed in the District Court of the United States for the District of Columbia. The Commissioner moved to dismiss on the theory that he was not a *proper party*. This court held that the Commissioner was a *proper party*. The opposer was *not* named as a defendant; but it is apparent that the motion to dismiss was *not* grounded upon the *absence* of the opposer as an *indispensable* party which is the primary issue in the present cases. Because of that material difference in the facts and in the issues to be decided, the Tomlinson decision is clearly distinguishable from the present case, and is of little or no weight as a precedent upon which to base a decision in the present case.

That the decision of this court in the Tomlinson case correctly holds that the Commissioner of Patents is a *proper party* in proceedings under R. S. 4915 is not questioned. However, appellee respectfully submits that that decision cannot properly be construed to support jurisdiction against the Commissioner of Patents alone, in an action where there has been an opposing party in the patent office, who also has been named defendant in the District Court action.

It seems clear that appellant has sought to unduly extend the comments of this court with respect to the absence of an opposer named as defendant in the U. S. District Court, in disregard of the actual inter-partes issues involved in the patent office and the naming of the opposer in the complaints filed in the District Court in these cases. Thus, at page 67 of its reported decision, this court states:

* Emphasis in quotations is supplied by counsel, unless otherwise indicated.

“Again, the language of the statute upon which the Commissioner relies is not satisfied in the present case. Appellant brought this suit against the Commissioner alone. In other words, there was no opposing party in the proceeding in the District Court from which this appeal was taken. A proceeding under that section is a new proceeding in equity. It is not an appeal from the Patent Office decision. The law requires in a case such as the present that service be made upon the Commissioner.

We held recently in *Radtke Patents Corp. v. Coe*, that the Commissioner's motion to be dismissed in that case should be denied. We did so on the theory that he was a proper party, because the issue of invention and patentability was necessarily involved. In that case opposing parties were named, as such, in the complaint and, presumably, it was not necessary to serve a copy of the bill upon the Commissioner. Nevertheless, he was a proper party.”

As stated by the court, the only question was whether or not the Commissioner was a *proper* party. The issue of dismissal because of the absence of an *indispensable* party was *not* presented to the court; and certainly is not determined by the Tomlinson case.

Speed Products Co. Inc. v. Tinnerman Products, Inc., 77 U. S. P. Q. 447.

Another case relied upon by appellant is the decision of this court in *Speed Products Co. Inc. v. Tinnerman Products, Inc.*, 77 U. S. P. Q. 447. Here again the decision of this court rested upon the peculiar facts of the case; and does not determine the issues of the present cases. In that case, Speed Products Co. Inc. was an applicant whose application for registration was successfully opposed by Tinnerman Products, Inc. Following the decision of the Commissioner the applicant filed two suits, one in the District Court of the United States for the District of Columbia in which it initially named only the Commissioner of

Patents as defendant, and the other against Tinnerman in the U. S. District Court for the Southern District of New York. In both actions, the plaintiff sought relief under R. S. 4915. The opposing party (Tinnerman), by leave of court, intervened in the action brought against the Commissioner of Patents in the District Court for the District of Columbia; and, by counter claim, asked for a declaratory judgment that the registrations, on which it had opposed the Speed Products registration, were valid and infringed by Speed Products. In the New York action, Speed Products (the applicant) in addition to relief under R. S. 4915, asked for a declaratory judgment that Tinnerman's trademarks were not infringed; and Tinnerman, by counterclaim, alleged infringement.

At the time appeal was taken to this court the situation was briefly as follows: Speed Products, earliest filed action asking relief under R. S. 4915 was filed in the District Court of the District of Columbia. Tinnerman had promptly intervened in that action, and was a party defendant therein, when the appeal reached this court. As to the matter of validity and infringement of the Tinnerman trade-marks, the issue was first raised by Speed Products, action brought in New York. What this court, on appeal, was asked to decide was primarily a matter of which of the two district courts should try the issues. This court very properly decided the question on the basis that each claim should be tried by the court first acquiring jurisdiction. The Speed Products' (applicant's) claim under R. S. 4915 having first been filed in the District Court for the District of Columbia, and Tinnerman, (opposer in the patent office) having voluntarily appeared and submitted to the jurisdiction of that court, the District of Columbia case was obviously the first in time; and this court correctly ruled that, jurisdiction having attached, the case should proceed to trial ahead of the New York action on the same issue.

As to the issues of validity and infringement, the New York action was the earlier filed case. Those issues are of course distinct from the question of registration first raised in the District of Columbia action as between the parties, Speed Products and Tinnerman, jurisdiction as to those claims first attached in New York; and this court properly held that the District Court for the District of Columbia should not order a stay of the proceedings on those claims in the New York court.

The decision obviously rests upon the question of where jurisdiction first attached. As in the Tomlinson case, the question of whether or not the opposer in the patent office was an indispensable party in the District Court for the District of Columbia, was not raised. The Commissioner being a *proper* (though not an indispensable) party, and Tinnerman having voluntarily intervened, the District Court for the District of Columbia obviously had jurisdiction. No motion to dismiss for lack of an indispensable party was presented; and the decision does not decide that question.

APPELLEE'S AUTHORITIES

Since the decisions cited by appellant fail to resolve the issues presented in these cases, it is necessary to consider other authorities. It is believed that the decisions of the U. S. District Court in these cases are clearly supported by the following authorities:

First, jurisdiction is expressly limited by U. S. C. A. Title 35, Sec. 72a, which provides:

“Upon the filing of a bill in the district court of the United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a

foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28;”—

In an inter-partes case, such as the present opposition proceedings, the action may be brought in the District Court for the District of Columbia if there are “adverse parties residing in a plurality of districts not embraced within the same state”. Otherwise jurisdiction is determined by the residence of the indispensable adverse party.

The Commissioner of Patents is neither an adverse party, nor an indispensable party in a proceeding of this character:

“It is contended that the Commissioner, if not a necessary party, is at least a proper and therefore an adverse party. But even if he were a proper party to a suit to review his award of priority, we think he *would not be ‘adverse’* within the meaning of the statute. *The Commissioner has not the slightest interest adverse to plaintiff; whether plaintiff or defendant gets a patent, the Commissioner neither gains nor loses.* ‘To hold that the plaintiff by making a mere formal party a codefendant can compel the real defendant, *the real party in interest*, to come from any part of the United States and defend his rights in the District of Columbia would conflict with the general purpose of Congress as appears from the fact that ordinarily suits in the federal courts must be brought in the district in which the defendant resides.’ *Standard Oil Company (Indiana) v. Pure Oil Company*, D. C., 19 F. Supp. 833,835; 28 U. S. C. § 112, 28 U. S. C. A. § 112.

Plaintiff, the Hobart Company, contends that it and defendant Cunningham are themselves ‘adverse parties residing in a plurality of districts’ within the mean-

ing of the Act of 1927. We cannot sustain the contention. We think the statute contemplates a plurality of parties adverse to the plaintiff. Had Congress meant, 'if it shall appear that the plaintiff and defendant reside in different districts,' Congress could easily have said so. Moreover, there was no occasion to allow suit in the District of Columbia whenever plaintiff and defendant reside in different districts."—

Coe, Commissioner of Patents, v. Hobart Mfg. Co.,
102 F. 2d 270 at 271 and 272.

"We come now to the question of whether, in the absence of defendant Carney, the Commissioner is an adverse party within the meaning of the statute. A careful search of authorities leads to the conclusion that the question must be answered in the negative."

Thorne, Neale & Co., Inc. v. Coe, Comm'r of Patents,
et al., 60 U. S. P. Q. page 124 at 125.

"We are of the opinion that the court below erred in ruling that the Commissioner of Patents was a necessary party, and in dismissing the bill of the plaintiff on that score. Section 4915 of the Revised Statutes, 35 U. S. C. A., § 63, which controlled the proceedings, provides: 'In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner.' In this case there *was* an opposing party. The defendant had filed an opposition to the registration of the contested trade marks before the Examiner of Interferences in the Patent Office. It had continued its opposition when an appeal was taken and prosecuted by the plaintiff to the Commissioner of Patents, who affirmed the decision of the Examiner of Interferences; and it also filed an answer to the proceedings in equity under Section 4915 before the court below. See *in re Hammer*, D. C., 300 F. 246, affirmed, 2 Cir., 6 F. 2d 460; *Graham v. Teter*, C. C., 25 F. 555; *Butler v. Shaw*, C. C., 21 F. 321; *The Mergenthaler Linotype Co. v. Seymour*, 66 O. G. 1311, 1894 C. D. 186; *Cleveland Trust Company v. Nelson et al.*, D. C., 51 F. 2d 276."

Century Distilling Co. v. Continental Distilling Co.,
106 F. 2d. page 486 at 488.

Appellee, Nancy Ann Storybook Dolls, Inc. as opposer in the patent office proceedings is an *adverse* party, and an *indispensable* party, in any proceedings under R. S. Sec. 4915:

“—We still think it evident that the validity of a patent or trademark cannot be litigated, as appellant seeks to do here, in a suit to which its owner is not a party. The party who was successful in the Patent Office interference or opposition proceedings, and has *obtained* or *retained* the disputed patent or trademark, is an *indispensable* party to a suit which seeks to cancel it. This is an elementary and obvious matter of due process. Moreover, section 4915 permits suit against the Commissioner only ‘where there is no opposing party’.”

J. C. Eno (U. S.) Limited v. Coe, Commissioner of Patents, 106 F. 2d. 858 at 859.

“Since the court does not have jurisdiction over defendant Carney, it would appear that this brings the present case squarely in line with the Eno case, *supra*. Grounds 2 and 3, therefore, are sustained and the motion to dismiss is granted. Appropriate order may be submitted.”

Thorne, Neale & Co., Inc. v. Coe, Comm’r of Patents, et al., 60 U. S. P. Q. 124 at 126.

The foregoing authorities clearly point to an affirmance of the decisions subject to these appeals. Whatever uncertainty has heretofore existed has undoubtedly arisen because of the absence of express statutory law, and differences which have sprung from decisions of the courts exercising their discretion in cases involving varying facts and equities. Congress has recognized the problems which have arisen; and in the New Trade-Mark Law, effective July 5, 1947, Section 21, has expressly extended to trademarks the provisions of R. S. 4915. The new law in addition provides:

“The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under Revised Statutes 4915, but he shall be notified of the filing of the bill by the Clerk of the Court in which it is filed and the Commissioner shall have the right to intervene in the action.”

There is no longer any room to speculate as to what Congress intended. Actions in inter-partes trade-mark cases, filed under the provisions of R. S. 4915 are against the opposing party, and must of course be brought in the jurisdiction where he is found. The Commissioner is *not* a necessary party. The decisions of the District Court for the District of Columbia, including the decisions here appealed from, are in conformity with the weight of prior authorities, and the new trade-mark statute.

CONCLUSION

It is believed that the law and authorities point conclusively to the dismissal of the actions by the District Court in these cases; and it is submitted that this Court should affirm the judgments in which the District Court has so held.

Respectfully submitted,

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No. 9911-12
SUPPLEMENTAL BRIEF FOR APPELLEE,
NANCY ANN STORYBOOK DOLLS, INC.

United States Court of Appeals
DISTRICT OF COLUMBIA CIRCUIT

GARDEL INDUSTRIES, *Appellant,*

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,

and

NANCY ANN STORYBOOK DOLLS, INC.,
(Successor to Nancy Ann Dressed Dolls), *Appellees.*

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United States Court of Appeals
for the District of Columbia
Circuit
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United States Court of Appeals

DISTRICT OF COLUMBIA CIRCUIT

Appeals Nos. 9911 and 9912

GARDEL INDUSTRIES, *Appellant*,

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,

and

NANCY ANN STORYBOOK DOLLS, INC.,

(Successor to Nancy Ann Dressed Dolls), *Appellees*.

SUPPLEMENTAL BRIEF FOR APPELLEE,

NANCY ANN STORYBOOK DOLLS, INC.

Supplementing the brief of Appellee, Nancy Ann Storybook Dolls, Inc., heretofore filed in the above entitled proceedings, said appellee respectfully directs the attention of the court to the following further points and authorities material to the issues involved in the appeals. The materiality of these supplemental points and authorities has become apparent, or has been substantially increased, since the filing of appellee's principal brief; and their consideration by this court is believed to be in the interests of justice and a proper determination of the issues here involved.

SUPPLEMENTAL STATEMENT OF POINTS.

In addition to the points noted at page 5 of appellee's main brief, Nancy Ann Storybook Dolls, Inc. further submits:

(a) That the suits involving the orders herein appealed from were filed subsequent to the date upon which the Trade-Mark Act of 1946 became effective, namely July 5, 1947; and, hence, is subject to the provisions of that act.

(b) That because of the provisions of said Trade-Mark Act of 1946, the Commissioner of Patents is not a necessary party, and may be joined as a defendant only with his consent or on his request to intervene.

(c) That jurisdiction in these cases is subject to the provisions of U.S.C. Title 28, Sections 111 *and* 112 (now U. S. Code, Judiciary and Judicial Procedure, Sec. 1391); and appellee Nancy Ann Storybook Dolls, Inc., not being within the jurisdiction of the court where the actions here involved were brought, is entitled to insist that it be made a defendant only in the district of which said appellee is an inhabitant. Section 112 controls the question of venue, whether the present proceeding be treated as one arising under the Trade-Mark Act of 1905 or of 1946.

(d) That proceedings in these cases, directed against the Commissioner of Patents alone, would be futile since appellee Nancy Ann Storybook Dolls, Inc. is not subject to the jurisdiction of the court where the present actions were brought; and said court is without jurisdiction to adjudicate the rights and interests of said appellee, without its consent, regardless of whether the proceeding arose under the Trade-Mark Act of 1905 or of 1946.

(e) R. S. Section 4915 merely *authorizes* action by the Commissioner of Patents pursuant to the judgment of the

court having cognizance of an action brought thereunder; and it is not necessary that the Commissioner be subject to the mandatory powers of the court in the district where the action is tried.

(f) The established policy of the Commissioner of Patents is to abide by the decision of the U. S. District Court having cognizance of an action under R. S. Section 4915; and appellee knows of no instance in which the Commissioner has failed to proceed in conformity with the adjudication of a court filed pursuant to the provisions of said section. In event the Commissioner of Patents should for any reason, refuse in any case to abide by such an adjudication, the mandatory powers of the U. S. District Court for the District of Columbia are obviously available for compelling action if the facts of the case warrant such action.

(g) The decision of this court in the case of *Barron-Gray Packing Co. v. Kingsland*, 79 U.S.P.Q. 100, is not controlling in the present case for each of the following reasons:

(1) The decision did not take into account the statutory *right* of a necessary defendant to insist that suit be brought against him only in the jurisdiction where he is an inhabitant. (U.S.C. Title 28, *Sec. 112.*)

(2) The decision did not take into account the effect of U.S.C. Title 28, *Sec. 111*, providing that the judgment or decree of a court having jurisdiction of parties properly before it *shall not conclude or prejudice* other parties *not* regularly served with process nor voluntarily appearing before it. The Commissioner is *not* an interested party, and since the rights and interests of appellee Nancy Ann Storybook Dolls, Inc., cannot without its consent be

concluded or prejudiced by the judgment of the District Court in the present actions, the trial of the actions against the Commissioner of Patents alone would be futile.

(3) The proceedings in the *Barron-Gray* case were initiated under the Trade-Mark Act of February 20, 1905; and hence the Commissioner was a *proper* party to the proceeding, regardless of whether he was a *necessary* party, or whether the opposer was an *indispensable* party. The present actions were filed *after* the Trade-Mark Act of July 5, 1946 became effective, and hence in the present proceeding the Commissioner can be made a party only by his consent or at his request to intervene.

(4) The opposer in the *Barron-Gray* case did not appear in the action, or move for dismissal; and hence the rights of the opposer were not in issue. The right of the opposer to intervene was recognized by this court. Whether it was assumed that the opposer had waived or would waive the question of venue does not appear.

(5) The case involved only an issue of *similarity* of trade-marks in which the public interest is represented by the Commissioner of Patents; whereas the present case involves an issue of *priority* involving only the *private* interests of the opposing parties.

STATUTES.

R. S. Section 4915 (U.S.C. Title 35, Sec. 63) is quoted in appellant's brief (pp. 2-3). Emphasis should be given to the following provisions of the statute:

“the court *having cognizance thereof*, on notice to adverse parties and other due proceedings had, may

adjudge that such applicant is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall AUTHORIZE the commissioner to issue such patent *on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law*. In all cases where there is *no opposing party* a copy of the bill shall be served on the commissioner;”

U.S.C. Title 35, Sec. 72a, also quoted in appellant’s brief (pp. 3-4), provides that the U. S. District Court for the District of Columbia shall have jurisdiction under Title 35, Section 63 (or 66) only:

“if it shall appear that there is an adverse party residing in a foreign country, *or adverse parties residing in a plurality of districts not embraced within the same State,*”

U.S.C.A. Title 28, Sec. 111, quoted at page 4 of appellant’s brief expressly provides that

“the judgment or decree rendered therein *shall not conclude or prejudice other parties not regularly served with process nor voluntarily appearing to answer;*”

U.S.C.A. Title 28, Sec. 112, which was in effect at the time the present actions were filed, and which is embodied in all material substance in Section 1391 of the new Title 28, Judiciary and Judicial Procedure, provides:

“except as provided in Sections 113 to 118 of this title, no civil suit shall be brought in any district court against any person by any original process or proceeding *in any other district than that whereof he is an inhabitant;*”

ARGUMENT.

The special jurisdiction of the U. S. District Court for the District of Columbia, conferred by U.S.C. Title 35, Sec. 72a, in actions filed under R.S. 4915, is expressly limited, and does not extend to appellee, Nancy Ann Storybook Dolls, Inc., in these cases because of the absence of "adverse parties residing in a *plurality of districts* not embraced within the same State."

Venue therefore depends upon U.S.C. Title 28, Sec. 112. Appellee has not submitted to the jurisdiction of the U. S. District Court for the District of Columbia; and submits that, as a matter of statutory right, it may properly insist that an action involving its rights and interests, as in the present case, must be brought in the district of which it is an inhabitant. See:

Thompson v. Terminal Shares, 104 F.2d 1, holding:

"To sustain the lower court's jurisdiction of this suit would do violence to the general policy of Congress that persons shall not be subjected to civil suits except in the districts of which they are inhabitants. Sec. 51 of the Judicial Code, 28 U.S.C. § 112, 28 U.S.C.A. § 112;"

The question of proper venue in an action brought in federal district court must be decided under Sec. 112 et seq. of Title 28 unless such sections are waived. *Badger v. Reich Bros.*, 161 F.2d 289 (Affirmed 68 S. Ct. 587; 333 U. S. 163).

The privilege of insisting that suit be brought only in the district where the defendant is an inhabitant is a matter of substantive right which may or may not be waived, as a party may elect. See:

Durabilt Steel Locker Co. v. Berger Mfg. Co., 21 F.2d 139;

Krueger v. Hider, 48 F. Supp. 708;
Lee v. Chesapeake & O. Ry. Co., 43 S. Ct. 230; 260
 U. S. 653;
Butterworth v. Hill, 5 S. Ct. 796; 114 U. S. 128;
Arbetter Mach. Co. v. Lewis Blind Co., 230 F. 992.

The present suits were filed *after* the Trade-Mark Act of 1946 came into effect, and are controlled by that act. The actions are not mere appeals from a Patent Office ruling, but are proceedings *de novo*.

See:

Morgan v. Daniels, 153 U. S. 120; 14 S. Ct. 772;
Nichols v. Minnesota Mining & Mfg. Co., 109 F.2d
 162;
Safeway Stores Inc. v. Dannel, 80 U.S.P.Q. 115.

Jurisdiction in these proceedings must therefore conform to the Trade-Mark Act of 1946, and that act expressly provides:

"The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under Revised Statutes 4915, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action."

Since the Commissioner of Patents is *not* a necessary party, and *the only interests adverse to plaintiff* are those claimed by Nancy Ann Storybook Dolls Inc., it is obvious that the action is *not* one in which the U. S. District Court for the District of Columbia has jurisdiction and venue to determine the rights of Nancy Ann Storybook Dolls Inc.

Assuming that the Commissioner of Patents is a proper (though not necessary) party to the proceedings, his

participation is solely that of an administrative officer who has acted in a quasi-judicial capacity in determining the relative rights of the principal parties in interest. His decision is subject to review by the U. S. Court of Customs and Patent Appeals. As an alternative to an appeal, the parties may proceed by suit in the U. S. District Court under R. S. 4915. The interested parties are the contestants, not the Commissioner. Where, as here, only one adverse party is involved, the accepted practice has been to bring the suit in the district where the party prevailing in the Patent Office proceeding resides. The reports include many cases so filed, and determined. For example see:

Solventol Chem. Prod. v. Langfield, 41 F. Supp. 877
(reversed on other grounds, 134 F.2d 899);
Vogel v. Crown Cork & Seal Co., 36 F. Supp. 74.

No case has been found where the Commissioner has refused to accept and abide by the decision of whatever U. S. District Court may have been called upon to adjudicate the rights of parties under R. S. 4915. It has long been expressly recognized that jurisdiction does not depend upon the immediate and direct power of any particular court to enforce its decree against the Commissioner. See: *Vermont Farm Mach. Co. v. Marble*, 20 F. 117 holding:

"It is further objected against the jurisdiction here that the court here could not compel obedience of the commissioner at the patent office to its decree. It is to be presumed, however, that a high officer of a department of the government will do his duty without compulsion, or even command, from any quarter, especially in a matter where he has no interest, nor the government any, except that the duty be done. This provision of the statute is framed

according to this view. The court does not decree that the commissioner shall issue a patent, but only 'may adjudge that such applicant is entitled according to law to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent,' etc."

Obviously, should the Commissioner of Patents refuse to abide by the adjudication of a competent court filed pursuant to the provisions of R. S. 4915, relief in a proper case may be secured by mandamus in a court having immediate jurisdiction over the Commissioner.

THE BARRON-GRAY CASE.

In the *Barron-Gray* case supra, there was one issue and that alone "of confusing similarity". The Section of the statute under which this issue is established states "trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake *in the mind of the public* or to deceive purchasers shall not be registered".

(Section 5, Trade-Mark Act of February 20, 1905, 15 U.S.C. 85).

The single issue of the *Barron-Gray* case therefore was a public question "hence, the public interest cannot properly be served without the participation of the Commissioner".

(*Tomlinson of High Point v. Coe*, 74 App.D.C. 364, 123 F.2d 65).

Both the *Tomlinson* and the *Barron-Gray* cases only hold that the Commissioner is a proper party. They do not hold that the Commissioner is an indispensable party.

The *Barron-Gray* case only holds that the non-resident opposer is not an indispensable party and that the litigation can go on in this district against the Commissioner of Patents alone. When limited to a public question which was the only issue in the *Barron-Gray* case, the Commissioner of Patents has been decided to be the proper party defendant; but as to private issues between opposer and an applicant for registration, the successful opposer in the Patent Office still seems to be an indispensable party. If he is not a resident of this district a suit under Section 4915 R.S. would, it seems, still have to be brought in the district of such *opposer's residence*. In the present appeals we have the issue of *priority of use* of the trade-marks which is *not* a public question but strictly a *private issue* between appellant and appellee, Nancy Ann Storybook Dolls, Inc. This issue cannot be tried *without* the presence of appellee, Nancy Ann Storybook Dolls, Inc.

In *J. C. Eno (U.S.) Limited v. Coe, Commissioner of Patents*, 106 F.2d 858, this Court stated:

"There the plaintiff asked only that the court prevent the cancellation of the plaintiff's trade mark. Here the plaintiff asks the court to require the cancellation of Deshayes's mark, and due process therefore requires that Deshayes be made a party."

In the instant appeals, appellant's complaint, paragraph 11, raises the following issue:

"but plaintiff avers that defendant has not shown nor legally proven use of said trade-marks *from a date prior to the first date of use by plaintiff* of its

aforesaid trade-mark, so that defendant cannot be damaged, within the meaning of the Trade-Mark Law, by the registration of plaintiff's aforesaid trade-mark."

(Joint Appendix, page 5A, line 12, et seq.)

and plaintiff-appellant in prayer B appended to its complaint prays:

"that defendant has not proven use of its alleged trade-marks 'Birthday Dolls' and 'Dolls of the Month' from a *date prior* to the date of first use by plaintiff of its aforesaid trade-marks."

CONCLUSION.

In the light of the points and authorities above noted, and for each and all of the reasons indicated, it is submitted that the U. S. District Court for the District of Columbia is without jurisdiction to hear the actions here involved; and that the orders dismissing said actions, both as to Nancy Ann Storybook Dolls Inc., and the Commissioner of Patents should be affirmed.

Respectfully submitted,

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BRIEF FOR APPELLEE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeals Nos. 9911 and 9912

GARDEL INDUSTRIES, APPELLANT

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,
AND NANCY ANN STORYBOOK DOLLS, INC. (SUCCESSOR
TO NANCY ANN DRESSED DOLLS), APPELLEES

SUPPLEMENTAL BRIEF ON BEHALF OF APPELLEE,
LAWRENCE C. KINGSLAND

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*United States Court of Appeals
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Joseph W. Stewart

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(1)

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeals Nos. 9911 and 9912

GARDEL INDUSTRIES, APPELLANT

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,
AND NANCY ANN STORYBOOK DOLLS, INC. (SUCCESSOR
TO NANCY ANN DRESSED DOLLS), APPELLEES

SUPPLEMENTAL BRIEF ON BEHALF OF APPELLEE,
LAWRENCE C. KINGSLAND

I

The present proceeding is governed by the provisions of the Lanham Trade-Mark Act of 1946 and not by the provisions of the now repealed Act of 1905

The appellee Kingsland at the time of filing of his main brief was under the erroneous assumption that the complaint in this case had been filed before the effective date of the new Act on July 5, 1947, while in fact this action was not instituted until February 1948. Section 46 (a) of the new Act provides as follows: "This Act shall be in force and take effect one year from its enactment, *but except as otherwise herein specifically provided shall not affect any suit, proceeding, or appeal then pending.* * * *" It, therefore, becomes necessary for this Court in the first instance to decide whether the present action was "a suit, proceeding, or appeal" pending on July 5, 1947. If

it was so pending, then admittedly the Act of 1905 would still govern this case. If, on the other hand, it was not "pending," then the provision of section 21 of the new Act hereinafter quoted becomes applicable under which the Commissioner shall not be a necessary party to an inter partes proceeding, but has a right to intervene in the action. It would seem clearly to follow from this language that he cannot be made a party to this proceeding without his consent.

II

It is well-settled that an equity action under Section 4915 R. S. is a proceeding de novo and not an "appeal"

The nature of the present action is clearly defined by the leading case of *Morgan v. Daniels*, 153 U. S. 120. The United States Supreme Court there held unequivocally that a 4915 proceeding was "something more than a mere appeal." The Court said:

* * * It is an application to the court to set aside the action of one of the executive departments of the Government. The one charged with the administration of the patent system had finished its investigations and made its determination with respect to the question of priority of invention. That determination gave to the defendant the exclusive rights of a patentee. *A new proceeding is instituted in the courts—a proceeding to set aside the conclusions reached by the administrative department and to give to the plaintiff the rights there awarded to the defendant.* It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence. * * * [Italics supplied.]

This Court has time and again expressed the same view. Thus, in *The American Steel and Wire Co. of N. J. v. Coe*, 105 F. 2d 17, 70 App. D. C. 138, this Court said:

* * * The proceeding under Section 4915, R. S., is a proceeding de novo in equity and, while the inquiry therein must be confined to the invention claimed in the Patent Office, nevertheless, "It is not a technical appeal from the Patent Office, like that authorized in § 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits" (p. 84).

And, in *Nichols v. Minnesota Mining & Mfg. Co.*, 109 F. 2d 162 (C. C. A. 4th, 1940), the court said:

* * * A suit under R. S. 4915 is not in the nature of an appeal but of a trial de novo; and the court has all the customary power of an equity court to hear the evidence fully and make its own findings. * * * (p. 187).

That this rule which was applied by the Supreme Court in a 4915 action involving the issuance of a patent applies with equal force to trade-mark cases has never been doubted since the Supreme Court's decision in *Baldwin Co. v. Robertson*, 265 U. S. 168. It was so applied only a few weeks ago by the Circuit Court of Appeals for the Ninth Circuit in the case of *Safeway Stores, Inc. v. Dunnell*, 80 U. S. P. Q. 115.

If it is true then, that a proceeding under R. S. 4915 such as the present action is, in the words of the Supreme Court, "more than a mere appeal," and "a new proceeding" in the nature of a proceeding to set aside a judgment, it cannot be considered "an

appeal, proceeding, or suit" which was pending when the new Act became effective in July 1947, since it was only instituted some eight months later. Nor can it be argued that section 47 (a) rather than 46 (a) applies to the present case. Under the former section, the prosecution of applications filed under the old Act and not converted shall be proceeded with in accordance with the Act under which the applications were filed. The section continues to say that the old acts shall be considered "continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof." It is clear that section 47 (a) refers only to prosecution of applications in the Patent Office and has no application to new proceedings relating to a pending application which were instituted after the effective date of the new Act. Under the specific provision of section 46 (a) such proceedings are not considered a part of the prosecution of a pending application, but are in the nature of independent proceedings governed by the provisions of the new law.

III

**Under the applicable section of the Trade-Mark Act of 1946,
the Commissioner of Patents is not a necessary party**

The last sentence of section 21 of the new Act provides:

The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under Revised Statutes 4915, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.

The purpose of this new section, which was suggested by various Patent Office officials during the hearings, was twofold: In the first place, it was pointed out that it was anomalous for the Commissioner of Patents who had acted in a quasi-judicial capacity in a contested inter partes case to become the sole defendant in a matter which primarily involves another private party's interests rather than the interests of the public. Thus, former Assistant Commissioner Fenning said at the hearings:

I am suggesting that we do add in section 21 the words, "The Commissioner shall not be a party in inter partes cases." You see, when it is an inter partes case the parties themselves have fought in the Patent Office. The Commissioner has been the judge who had decided the case, and it would seem unreasonable to let the judge be the only party defendant. (Hearings before the Subcommittee on Trade-Marks, Committee on Patents, on H. R. 102, H. R. 5461, and S. 895, 77th Cong., 1st Sess., Nov 4, 12, 13 and 14, 1941, at p. 142.)

The same view was expressed, among others, by the late Assistant Commissioner Frazer, who was specifically asked for comment by Chairman Lanham with regard to the advisability of a provision of this kind. Mr. Frazer said:

We feel very strongly that the Commissioner of Patents should not be joined as a party in any inter partes case. We see no necessity for it (*Ibid.*, at p. 143).

This legislative recognition of the fact that the public interest, if any, in the ordinary opposition, interference, or cancellation proceeding is secondary

to the disposition of a controversy between two contesting parties would seem to remove all doubt as to the position of the Commissioner of Patents in inter partes cases which come within the scope of the new Act of 1946; the Commissioner is given a right to intervene but he cannot be made a party against his will, nor is he a necessary party in such proceedings.

The second ground for enacting the new section was to protect parties such as the co-appellee in the present suit from the inconvenience of having to defend an action in the District of Columbia rather than at his domicile at California. Under the new Act, even if the Commissioner should desire to intervene because the proceeding may involve some question of public interest in addition to the primary issue of the respective rights of the parties, the proper forum would still remain that of the co-appellee's domicile or place of business.

We submit, therefore, that under the provisions of the new Trade-Mark Act, which governs this proceeding, the present action was improperly instituted in the District of Columbia, that the Commissioner of Patents cannot be made a party to this suit without his consent, and that the lower court's decision dismissing the complaint against him should be affirmed.

Respectfully submitted.

W. W. Cochran,
Solicitor, United States Patent Office.

WALTER J. DERENBERG,
Of Counsel.

MAY 1949.

BRIEF FOR APPELLEE LAWRENCE C. KINGSLAND

United States Court of Appeals

DISTRICT OF COLUMBIA

Nos. 9911 and 9912

GARDEL INDUSTRIES, APPELLANT

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,
AND NANCY ANN STORYBOOK DOLLS, INC. (SUCCESSOR
TO NANCY ANN DRESSED DOLLS), APPELLEES

APPEAL FROM AN ORDER OF THE DISTRICT COURT OF THE
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(I)

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*APPEAL FROM AN ORDER OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA*

BRIEF FOR THE COMMISSIONER OF PATENTS

STATEMENT

This is an appeal from an order (21A)¹ of the District Court of the United States for the District of Columbia granting appellees' motions to dismiss the complaints (2A and 12A) in Civil Actions Nos. 717-48 and 718-48, filed February 20, 1948, against the Commissioner of Patents and Nancy Ann Storybook Dolls, Inc., codefendants. These actions were brought under Section 4915 of the Revised Statutes (U. S. C. Title 35, Sec. 63) seeking to compel the

¹ The numbers in parentheses refer to pages in the joint appendix.

Commissioner of Patents to issue to the appellant certificates of registration of its two marks "Birthstone Doll" and "Birthstone Doll of the Month," as more fully specified in the two applications, Serial Nos. 479,619 and 479,620, filed February 9, 1945.

The Examiner of Trade-Marks passed these two marks to publication and they were published in the Official Gazette on April 10, 1945 (3A). On May 7, 1945, Nancy Ann Dressed Dolls, the predecessor of the codefendant Nancy Ann Storybook Dolls, Inc., who was subsequently substituted for the former, filed opposition to the registration of these marks alleging prior use and ownership of certain then unregistered trade-marks including the mark "Birthday Doll."² The Examiner of Interferences dismissed the opposition on the ground that opposer had failed satisfactorily to prove prior use of these marks. But upon appeal to the Commissioner of Patents, the Commissioner reversed the decision of the Examiner of Interferences and sustained the codefendant's opposition on August 20, 1947. The Commissioner ruled that the codefendant opposer had succeeded by oral proof in establishing prior use of the mark "Birthday Doll" and that in his opinion there was a likelihood of confusion between that mark and the marks which plaintiff seeks to register. He further held that the codefendant would be damaged if plaintiff's applications for registration of Serial Nos. 479,619 and 479,620 were granted.

² This mark was subsequently registered for the opposer on December 31, 1946, while the opposition proceeding was pending.

The present suit was then instituted in the District Court of the United States for the District of Columbia to compel the Commissioner to grant said registrations. Both the successful opposer and the Commissioner were named defendants.

The codefendant Nancy Ann Storybook Dolls, Inc., immediately moved to dismiss the complaint on the ground that the Court lacked jurisdiction over it, the codefendant being a California corporation, and that the Commissioner of Patents was not an adverse party to the proceeding under Section 4915. A few days later, the codefendant Kingsland joined in the motion of the codefendant Nancy Ann Storybook Dolls, Inc., and likewise moved that the complaint be dismissed as against him on the ground that the action could not proceed against the Commissioner alone in the absence of a necessary party and that the successful opposer was an indispensable party to the present proceeding.

Hearing was had on the motions before Justice Letts of the District Court of the United States for the District of Columbia, and thereafter, the motions to dismiss were granted and orders thereon entered April 30, 1948, dismissing the complaints (10A, 11A, and 21A). The plaintiff's present appeal seeks reversal of the District Court's order dismissing the complaints. The two appeals here involved were ordered consolidated upon joint motion of the parties by this Court in its order of August 7, 1948.

SUMMARY OF ARGUMENT

1. An action under Section 4915 R. S. seeking a review of the decision of the Commissioner of Patents sustaining an opposition to registration of a trade-mark on the ground that it is confusingly similar to an opposer's previously registered mark, cannot proceed against the Commissioner of Patents alone; the successful opposer is an adverse party within the meaning of said section and is an indispensable party to such an action.

2. This principle is not in conflict with this Court's decision in the case of *Tomlinson of High Point v. Coe, Commissioner of Patents*, 74 App. D. C. 364, 123 F. (2d) 65, or the case of *Speed Products Co., Inc. v. Tinnerman Products Inc.*, 77 U. S. P. Q. 447 (1948). The only question decided in the Tomlinson case was whether the Commissioner of Patents is a proper party to such an action.

3. The opposer Nancy Ann Storybook Dolls, Inc., is an indispensable party because a judgment herein would have the effect of an adjudication of the scope of opposer's registered trade-mark "Birthday Doll"³ and because the main issue in this case is whether or not the opposer would be damaged by the granting of plaintiff's applications for registration.

4. Section 21 of the new Trade-Mark Act of July 5, 1946, which expressly provides that the Commissioner of Patents shall not be a necessary party to any inter partes proceeding under Section 4915 R. S. does not

³ This mark was subsequently registered for the opposer on December 31, 1946, while the opposition proceeding was pending.

embody a new principle of law but merely reflects preexisting law.

ARGUMENT

It should be stated at the outset that this appeal does not present the question whether the Commissioner, if not a necessary party, is at least a proper party in a proceeding instituted by an unsuccessful applicant for registration whose mark is rejected on the ground of a previously registered mark of a successful opposer. It was that issue—and that issue only—which was before this Court in the *Tomlinson* case, *supra*. It is true that the *Tomlinson* case involved a situation where a defeated applicant sued the Commissioner of Patents without joining the opposer as a party and the issue of the absence of an indispensable party might well have been raised by the Commissioner in that case but was not. The Commissioner there based his entire defense on the ground that he should not be a party at all to a proceeding under Section 4915 R. S. in an *inter partes* suit. In other words, it was there argued that in a proceeding under Section 4915 which resulted from an *inter partes* case the Commissioner of Patents was not even a proper party and could not be named as a defendant at all. This Court, in rejecting the Commissioner's argument, held that the Commissioner was a proper party even in a proceeding under Section 4915 which involved *inter partes* rather than *ex parte* issues, but the issue now before the Court, i. e., whether the successful opposer is an indispensable party, was not even discussed in the opinion of this Court in the *Tomlinson* case.

The *Tomlinson* decision, being completely silent on the issue involved in the present appeal, is therefore no authority for the proposition that the opposer is not an indispensable party in a proceeding under Section 4915, since the scope of the decision is limited to a ruling that the Commissioner is a proper party in such a proceeding. Moreover, the situation in the *Tomlinson* case is distinguished from the situation here, by the fact that there the opposer Colonial Williamsburg, Inc., had no trade-mark registration, while here the defendant now has a registration of "Birthday Doll," the scope of which would necessarily be adjudicated by a judgment in this case.

Nor does the present case bear any relationship to a line of cases in which the Commissioner of Patents dismissed the opposition but then went on to reject an application on *ex parte* grounds, such as descriptiveness. Such was the situation, for instance, in *Bradstone Rubber Co. v. Coe*, 46 USPQ 410, 34 F. Supp. 926 and *James Heddon's Sons v. Coe*, 59 USPQ 315, 51 F. Supp. 490. It has never been doubted that in such situations a proceeding under Section 4915 against the Commissioner alone is entirely proper, since the sole issue before the Court then would be a point neither raised by the opposer nor in any way affecting his own rights, since the opposition had already been dismissed by the Commissioner on other grounds.

Appellant's principal argument appears to be based on the misconception that the present case presents an *ex parte* rather than an *inter partes* issue and that for that reason there is not here "an opposing party."

Appellant actually argues that a proceeding under Section 4915 would involve an *inter partes* issue where the opposer succeeds on the ground of a showing of a superior priority but would not raise such issue where the opposer succeeded because of a showing of confusing similarity. Appellant goes so far as to suggest at page 11 of his brief that the opposer is "merely a formal party, presenting to the Patent Office, if possible, some grounds for refusal by the Commissioner of a trade-mark sought to be registered under the Statute." Appellant goes on to reason that if the opposer shows to the Patent Office use of the same or a similar mark, the refusal to register then becomes a "refusal *ex parte*." On page 13 of his brief, he again alleges that the sustaining of the opposition amounts in effect to an *ex parte* rejection. This argument completely overlooks the fact that in most instances the cardinal issue is not whether or not the mark is originally registrable—the Patent Office having already determined by publishing for opposition that it deemed the mark registrable—but whether the opposer in view of a mark previously registered by him would suffer damage. This interest of the opposer, who was previously sustained by the Patent Office on the issue of damage, remains the controlling issue regardless of whether the opposer succeeded below on the ground of priority or confusing similarity or any other reason. In other words, as long as an opposer is successful in the Patent Office and an equity proceeding is instituted to reverse the Patent Office holding that the opposer would be damaged by registration of the applicant's

mark, the nature of the proceeding and the issue involved remain *inter partes* and cannot be decided without joining the very party whose interests have been found to be adversely affected.

It is submitted that, whatever scant authority may be found on this precise issue, squarely supports the position taken here. The United States District Court in *Speed Products Co., Inc. v. Tinnerman Products, Inc.*, 73 USPQ 182 (S. D. N. Y.) clearly adopted this view. (This case subsequently came before this Court on various collateral issues.) In that case, an opposition had been sustained on the ground of confusing similarity by the Examiner of Interferences and by the Commissioner of Patents and—just as in the present case—the defeated applicant instituted a proceeding under Section 4915 seeking registration of his mark. The action was brought only against the successful opposer and the Commissioner was not joined as a party defendant. Defendant's motion to dismiss on the ground that the Commissioner was a necessary party was denied. The Court said:

When the Patent Office sustains opposition to registration of a trade-mark on the ground of confusing similarity to the opposer's prior registered trade-mark, the Commissioner of Patents is not a necessary party to an action against the opposer under Section 4915.

And again:

The defendant herein was an opposing party in the Patent Office. It has been named as such in this suit wherein it has filed an answer.

It is in every sense an adverse party within Section 4915 since the Patent Office decided in favor of its objections and claims and against those of plaintiff herein.

This holding thus indicates that a proceeding instituted by a defeated applicant against a successful opposer involves a decision "in favor of its [opposer's] objections and claims and against those of plaintiff * * *" thereby making the opposer rather than the Commissioner of Patents an indispensable party to the proceeding. Similarly, the federal court held in *Century Distilling Co. v. Continental Distilling Co.*, 106 F. (2d) 486 (C. C. A. 3), that the Commissioner was not a necessary party in any case in which an opposer had been sustained by the Patent Office either on an issue of priority or on an issue of confusing similarity. The pertinent paragraph of the Court's decision reads as follows:

We are of the opinion that the court below erred in ruling that the Commissioner of Patents was a necessary party, and in dismissing the bill of the plaintiff on that score. Section 4915 of the Revised Statutes, 35 U. S. C. A. § 63, which controlled the proceedings, provides: "In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner." In this case there was an opposing party. The defendant had filed an opposition to the registration of the contested trade-marks before the Examiner of Interferences in the Patent Office. It had continued its opposition when an appeal was taken and prosecuted by the plaintiff to the Commissioner of Patents, who affirmed the decision

of the Examiner of Interferences; and it also filed an answer to the proceedings in equity under Section 4915 before the court below (at p. 488).

While it is true that the final decision in the *Century* case rested on other grounds, it is significant that the Court expressly found the successful opposer to be still "an opposing party" in a subsequent proceeding under Section 4915, so that a suit against him alone without joining the Commissioner itself was held entirely appropriate.

It would certainly be unrealistic to conclude, as appellant here suggests, that the very party whose alleged injury prevented registration of a mark previously held otherwise registrable by the Patent Office, should not be a necessary and indispensable party in an action which seeks a determination of that identical issue! But it is unnecessary to rely on the cited cases to justify the position that the successful opposer must be joined as an indispensable party regardless of the ground on which his opposition was sustained. The decision of this Court in *J. C. Eno (U. S.) Ltd. v. Coe, Commissioner of Patents*, 106 F. (2d) 858 (C. A. D. C.), furnishes additional persuasive authority for this proposition. In the *Eno* case, the proceeding under Section 4915 was instituted by the unsuccessful opposer seeking to cancel the applicant's registration. The Commissioner there had found that the articles of the respective parties involved were not goods of the same descriptive properties and had dismissed the opposition on that ground and as a consequence had registered appli-

cant's mark. Both the successful applicant and the Commissioner of Patents were joined as defendants, but the bill was dismissed as to the successful applicant because he was a resident of Massachusetts and not of the District and the case proceeded against the Commissioner as sole defendant.

The Commissioner's motion to dismiss for lack of an indispensable party was granted by this Court. Said the Court:

In *Alexandrine v. Coe*, 63 App. D. C. 227, 71 F. (2d) 348, this court decided that when the Patent Office, in proceedings brought by A, has decided to cancel B's trademark, B may, without joining A as a defendant, sue the Commissioner under Section 4915 to enjoin the cancellation. We need not now consider whether that was properly a case "where there is no opposing party" within the meaning of Section 4915, for the present case differs fundamentally from the *Alexandrine* case. There the plaintiff asked only that the court prevent the cancellation of the plaintiff's trademark. Here the plaintiff asks the court to require the cancellation of Deshayes' mark, and due process therefore requires that Deshayes be made a party (at p. 859).

And again:

* * * We still think it evident that the validity of a patent or trademark cannot be litigated, as appellant seeks to do here, in a suit to which its owner is not a party. The party who was successful in the Patent Office interference or opposition proceedings and has obtained or retained the disputed patent or

trademark, is an indispensable party to a suit which seeks to cancel it. This is an elementary and obvious matter of due process. Moreover, section 4915 permits suit against the Commissioner only "where there is no opposing party" (at p. 859).

Can it be said, as appellant would have this Court rule, that in case of an unsuccessful opposition, the victorious applicant must be joined as a party defendant in a proceeding under Section 4915 (as this Court held in the *Eno* case) while in the present case the defeated applicant would not have to join the successful opposer under identical circumstances? Is the issue of confusing similarity and resulting damage to the opposer changed from an *inter partes* issue to an *ex parte* issue depending on whether this issue is determined in favor or against the opposer? It is submitted that the reasoning of this Court in the *Eno* decision applies with equal force to the situation here involved and that the issue of damage and injury to the opposer remains the true and sole issue before the Court regardless of whether the issue of confusing similarity was decided for or against the opposer by the Patent Office.

If the issue of damage to an opposer or injury to a petitioner for cancellation were an *ex parte* issue, as appellant strenuously argues in his brief, then it is not seen what conceivable issue in an opposition, interference, or cancellation proceeding could ever be characterised as "inter partes." The very language "injury to the petitioner" or "damage to the op-

poser" suggests that the issue here involved is not primarily one concerning the public interest or the Commissioner as guardian of the public, but is a matter of an adjudication of private rights between two litigants. The complaint in this case clearly shows that an issue in this case was the correct date of the co-defendant's first use of the term "Birthday Doll." It would certainly seem farfetched to argue that there is any public interest involved in the determination of the question of priority as between these two parties or—still more concretely—in the correctness of the Commissioner's ruling that the co-defendant's oral evidence satisfactorily established such priority date. Consequently, a decision which directly affects such private rights of an opposer or petitioner for cancellation should not be handed down by an equity court in the absence of the only party whose rights are directly and immediately affected, whether he may own a previous registration or not.

Finally, it may not be amiss to point out that the view here expressed has found full acceptance in the new Trade-Mark Act of July 5, 1946, which became effective on July 5, 1947. While it is, of course, true that the provisions of this new Act are not directly applicable to the present appeal [section 46 (a)], it is interesting to note that during the Congressional debates there was practical unanimity in recognizing that the Commissioner of Patents was not a necessary party in any proceeding under Section 4915 which arises out of and is concerned with an *inter partes* issue, but that the Commissioner should be permitted

in his discretion to intervene in such cases. Section 21 of the new Act as finally worded provides:

* * * The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under Revised Statutes 4915, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.

When this language was discussed during the 1941 Hearings, former Assistant Commissioner Fenning testified as follows:

I am suggesting that we do add in section 21 the words, "The Commissioner shall not be a party in inter partes cases." You see, when it is an inter partes case the parties themselves have fought in the Patent Office. The Commissioner has been the judge who had decided the case, and it would seem unreasonable to let the judge be the only party defendant. (Hearings before the Subcommittee on Trade-Marks, Committee on Patents, on H. R. 102, H. R. 5461, and S. 895, 77th Cong., 1st Sess., Nov. 4, 12, 13, and 14, 1941, at p. 142.)

The same view was expressed, among others, by the late Assistant Commissioner Frazer, who was specifically asked for comment by Chairman Lanham with regard to the advisability of a provision of this kind. Mr. Frazer said:

We feel very strongly that the Commissioner of Patents should not be joined as a party in any inter partes 4915 case. We see no necessity for it. (*Ibid.*, at p. 143.)

CONCLUSION

In conclusion, we call the Court's attention to the fact that this Court at the beginning of its decision in the *Tomlinson* case distinctly stated that the lower court had there granted the Commissioner's motion to dismiss the complaint on the ground that the Commissioner was not a proper party to the suit at all. "That"—the court said—"is the only question presented on this appeal." It is submitted, therefore, that the Order of the District Court in the present case was not contrary to the *Tomlinson* decision but was correct in holding that the successful opposer is an indispensable party to the present suit.

It is submitted that the Order of the District Court dismissing the complaint should be affirmed.

Respectfully submitted.

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WALTER J. DERENBERG,
Of Counsel.

SEPTEMBER 1948.